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16 July 2003

**SOLICITOR**

JUL 18 2003

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**U.S. PATENT & TRADEMARK OFFICE**

Re: In re W. Roy KNOWLES, Petitioner

Dear Mr. WHEALAN :

Enclosed for your review is a copy of a Petition for Writ of Mandamus with an accompanying Appendix, filed today with the Court of Appeals for the Federal Circuit.

We do not yet have a docket number assigned. Please let me know if you have any questions,



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Mbc:mp  
Enclosures

**SOLICITOR**

Docket No.

**JUL 18 2003**

**U.S. PATENT & TRADEMARK OFFICE**

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UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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*In re* Application of W. Roy KNOWLES, M.D.

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PETITION FOR WRIT OF MANDAMUS  
OR FOR  
REVIEW UNDER 35 U.S.C. 141

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BRIEF OF PETITIONER Knolltech Pharmaceutical Inc.,  
assignee of the application

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Attorney for Petitioner

July 15, 2003

THE COURT OF APPEALS FOR THE FEDERAL CIRCUIT

*In re* Application of

W. Roy KNOWLES, M.D.,

Petitioner.

No. \_\_\_\_\_

Petition for  
Writ of Mandamus (28 U.S.C. § 1651(a))  
Or for  
Appeal (35 U.S.C. § 141)

**THE RELIEF SOUGHT**

This PETITION is in response to the 22 May 2003 PETITION DECISION by the Director of Technology Center 1600, United States Patent Office.

In examining patent application Serial No. 09/619,142, the U.S. Patent Office has so far issued six OFFICE ACTIONS. Petitioner finds each one raises rejections which are unsustainable as a matter of law. Accordingly, Petitioner has sought appellate review of the Examiner's actions. The Examiner flatly refuses to allow the Board of Patent Appeals & Interferences to review her work.

Thus, Petitioner has to date filed four APPEAL BRIEFS and the Examiner has refused to allow the Board of Patent Appeals & Interferences to review any of these.

Withholding this application from the Board harms Petitioner because it denies Petitioner his Constitutional right to a patent, and the right to appellate review of any decision denying that patent.

Petitioner has therefore petitioned the Examiner's Director, asking him to forward the appeal to the Board. The Examiner's Director, understandably reluctant to have the Examiner's work reviewed by the Board, refused.

Petitioner thus respectfully requests the Court either:

- (A) issue a Writ of Mandamus pursuant to 28 U.S.C. § 1651(a) and FED. R. APP. PROC. Rule 21, requiring the Commissioner for Patents to forward the pending patent appeal to the Board; or
- (B) evaluate the substantive merits of the application and issue a Writ of Mandamus (i) mandating that Commissioner issue a NOTICE OF ALLOWANCE in this case; or (ii) enjoining the Commissioner from continuing to withhold a NOTICE OF ALLOWANCE; or
- (C) adjudicate the substantive merits of the application pursuant to 35 U.S.C. § 141.

#### **THE ISSUES PRESENTED**

Whether the Court can and should issue a writ of mandamus?

Whether the court can and should adjudicate the merits pursuant to 35 U.S.C. 141?

#### **THE FACTS NECESSARY TO UNDERSTAND THE ISSUES**

We will briefly review the procedural prosecution history to date. (A complete copy of the prosecution history, together with all references of record, is included as an Adobe® Acrobat file on a CD-ROM, in the Appendix.) We will not address the substantive merits, because the merits are fully discussed in the Feb. 20<sup>th</sup>, 2003 OFFICE ACTION and the July 16<sup>th</sup>, 2003 APPEAL BRIEF, copies of which are included in the Appendix.

THE PROSECUTION HISTORY FROM  
FILING TO THE FIRST APPEAL

Petitioner filed this application on 19 July 2000. The invention relates to maintaining healthy hair and preventing abnormal hair loss, by using *minoxidil* together with a *skin penetration enhancer* and a *testosterone blocker* or *inhibitor*. The art of record teaches each of these components, but teaches against combining them. *See generally* APPEAL BRIEF pgs. 2-5 (16 July 2003). The inventor turned this conventional wisdom on its head. He has found that, contrary to the teachings of the art, penetration enhancer can safely be used with minoxidil and a testosterone blocker or inhibitor - if used properly. Id.

On 31 Oct. 2000, the Examiner mailed the first OFFICE ACTION. The first OFFICE ACTION acknowledged that the art of record lacked certain claim limitations. The Examiner, however, quipped that the claim limitations not taught in the art were "not considered critical" - so she completely ignored them. The Examiner did not bother to provide any authority for her refusal to follow the Federal Circuit's mandate that each and every claim limitation is "critical." *See e.g., Akzo N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471 (Fed. Cir. 1986).

Furthermore, the Examiner made various factual assertions without bothering to provide any evidentiary support for them.

On 7 Feb. 2001, Petitioner Replied, traversing each rejection and swearing behind certain art with a DECLARATION. Petitioner also noted that it is illegal for the Examiner to rely on factual assertions not supported by any evidence of record. *See In re Ahlert*, 165 USPQ 418, 420 (C.C.P.A. 1970); *In re Eynde*, 178 USPQ 470, 474 (C.C.P.A. 1973); *Ex parte Grochowski*, No. 95-1343 at 5 (B.P.A.I., June 27, 1995); *Ex parte Nouel*, 158 USPQ 237 (B.P.A.I. 1967) (relying on a judicially-noticed fact to invalidate a claim is reversible error).

Petitioner thus invited the examiner to make of record an AFFIDAVIT OF REFERENCES with this evidence. See RESPONSE at pg. 9 (8 Feb. 2001).

On 27 March 2001, Examiner mailed another OFFICE ACTION. The OFFICE ACTION accepted the DECLARATION without objection. The Examiner nonetheless used the same art sworn behind in the DECLARATION, to reject the claims. The Examiner also ignored Petitioner's request for an AFFIDAVIT OF REFERENCES, yet continued to use her unsupported factual assertions to reject claims.

Petitioner concluded that the rejections were unsustainable on their face, as a matter of law. Thus, to obtain review of the Examiner's actions, on 26 April 2001 Petitioner filed an APPEAL BRIEF.

The Examiner refused to enter the APPEAL BRIEF. The Examiner said the headings used in the Brief were unacceptable. Office regulations expressly allow for *any* "appropriate" headings. 37 C.F.R. § 1.192. Nonetheless, the Examiner demanded the headings be rewritten to recite her preferred language *verbatim*.

## THE SECOND APPEAL

In the interests of expediency, on 18 July 2001 Petitioner filed an APPEAL BRIEF with revised headings. The Examiner again refused to forward the APPEAL BRIEF to the Board. To the contrary, on Sept. 28<sup>th</sup>, 2001, the Examiner issued another OFFICE ACTION. In so doing, the Examiner violated Office procedures for several reasons.

### The Examiner Objected to a Declaration The PTO Previously Ruled Acceptable

First, the Sept. 28<sup>th</sup>, 2001 OFFICE ACTION objected to the same DECLARATION the Examiner had previously accepted. This violates the Office's own procedure, because Office procedure requires the Examiner to point out every alleged deficiency in a Declaration in the

first responsive Office action, or the Declaration is deemed accepted. See MANUAL OF PAT. EXAM. PROC. ("M.P.E.P.") § 602.03.

Here, the first responsive office action was issued March 27<sup>th</sup>, 2001. That OFFICE ACTION accepts the Declaration without comment. Thus, the Examiner cannot later contest it. See M.P.E.P. § 602.03.

Furthermore, the Examiner is believed barred from contesting the Declaration as a matter of law, under the doctrine of collateral estoppel. Collateral estoppel applies to Patent Office proceedings. See Overland Motor Co. v. Packard Motor Co., 274 U.S. 417, 421 (1927) ("Especially is this [collateral estoppel] principle applicable to the proceedings of the Patent Office, which are so nearly akin to judicial proceedings as to be most appropriately designated as quasi-judicial."). Collateral estoppel precludes re-litigating any issue that was actually raised or that "could have been raised" previously. Allen v. McCurry, 449 U.S. 90, 94 (1980).

Here, the Examiner had the opportunity to raise the issue in the March 27<sup>th</sup>, 2001 OFFICE ACTION - but declined to do so. The Examiner is thus estopped as a matter of law from doing so later. *Id.*; see generally Schwartz, S.D., *Res Judicata As Applied in Patent Office Prosecution*.... 159 J. PAT. OFF. SOC. 637, 638 (1967) (in Patent Office proceedings, collateral estoppel is "an absolute bar" to re-litigation).

The Examiner Contradicted Her  
Own Earlier Factual Conclusions

Second, the Sept. 28<sup>th</sup>, 2001 OFFICE ACTION relied on factual assumptions which directly contradicted the Examiner's earlier factual findings. For example, the Sept. 28<sup>th</sup>, 2001 OFFICE ACTION said that the BAZZANO reference teaches a "notoriously known []

penetration enhancer," while the Oct. 31<sup>st</sup>, 2000 OFFICE ACTION expressly conceded that the BAZZANO reference does not teach penetration enhancer at all.

This is error, because the Office is estopped as a matter of law from contradicting its own prior factual findings. See In re Lundberg & Zuschlag, 126 U.S.P.Q. 412, 414 (C.C.P.A. 1960) ("Patentability over prior art is not considered as a virgin problem. On the contrary, [a] prior decision stands, right or wrong, for all issues there decided.").

*The Examiner Refused to Provide Evidentiary  
Support for Her Factual Assertions*

Third, the factual assertions in the Sept. 28<sup>th</sup>, 2001 OFFICE ACTION lacked evidentiary support in the record, despite Petitioner's request for an AFFIDAVIT OF REFERENCES.

*The Examiner Refused to Recognize  
Petitioner's Right Under PTO Rule  
192 To Proceed with the Appeal*

Lastly, the choice to reopen prosecution under 37 C.F.R. § 1.192 is applicant's choice, not the examiner's. See 62 Fed. Reg. 53170-71 (1997) ("any delay in prosecution resulting from the reopening of prosecution is to the detriment of the applicant. Thus, it is considered appropriate to give the applicant the choice of whether to prosecute the application before the examiner or reinstate the appeal").

Here, the Examiner did not give Petitioner the choice required by Rule 192. To the contrary, the Examiner simply issued the OFFICE ACTION.

On 10 Jan. 2002, Petitioner filed a RESPONSE. In so doing, Petitioner again reminded the examiner that it is illegal for her to rely on facts not supported by an AFFIDAVIT OF REFERENCES, and reiterated Petitioner's demand that the examiner make of record evidence supporting her assertions. See RESPONSE at pg. 3, note 1 (10 Jan. 2002), citing RESPONSE at pg. 9 (8 Feb. 2001).



On 9 May 2002, the Examiner mailed another OFFICE ACTION. It was roudling for several reasons.

First, the Examiner refused to provide an AFFIDAVIT OF REFERENCES, but continued to use the same unsupported factual assumptions to reject claims. This is not only illegal, the Examiner was fully informed by Petitioner's RESPONSE that it is illegal - and *did it anyway*.

Furthermore, the OFFICE ACTION recited rejections which had been previously raised in prior OFFICE ACTIONS, then conceded by the Examiner to be unfounded and withdrawn.

This is error because the examiner is estopped as a matter of law from re-litigating rejections previously conceded to be incorrect and withdrawn.

#### THE THIRD APPEAL

Petitioner thus believed the rejections again unsustainable as a matter of law. Accordingly, on 29 June 02, Petitioner filed another APPEAL BRIEF.

Predictably, the Examiner refused to forward the APPEAL BRIEF to the Board. To the contrary, the Examiner refused to do anything *at all* for nearly a year. Cf. M.P.E.P. § 1208 (Examiner must file EXAMINER'S ANSWER within two months after the APPEAL BRIEF is filed).

On 20 Feb. 03, rather than forwarding the (nine-month old) APPEAL BRIEF to the Board, the Examiner issued yet another OFFICE ACTION. Predictably, it raises rejections no more valid than those recited in the prior OFFICE ACTIONS. Predictably, it relies on factual assumptions which contradict the Examiner's earlier findings, and which lack evidentiary support.

THE PETITIONER ASKED THE  
EXAMINER'S DIRECTOR TO FORWARD  
THE APPEAL TO THE BOARD

Accordingly, on 29 Mar 2003, Petitioner filed a PETITION asking the Examiner's Director to please forward the nine-month old APPEAL BRIEF to the Board.

On 22 May 2003, the Examiner's Director denied the PETITION. The Director gave two reasons. Both are incorrect.

First, the Director asserts that the Board "does not accept applications for review unless both parties have provided appropriate arguments in the form of an Appeal Brief and Examiner's Answer." PETITION DECISION (22 May 2003). In other words, the Director says the Board will not accept an appeal at all, unless and until the Examiner decides that she is in the mood to write an EXAMINER'S ANSWER.

The Director appears misinformed. Appeal is not a nicety; Petitioner has a right to have its appeal heard. Steinmetz v. Allen, 192 U.S. 543 (1904). The Examiner's refusal to write an EXAMINER'S ANSWER (and her Director's failure to require her to do so) cannot divest Petitioner of this right.

Further, even the Office's own rules permit appeals without an EXAMINER'S ANSWER. *Cf.* 37 C.F.R. § 1.193(a)(1) (Examiner *may* file EXAMINER'S ANSWER if believed warranted).

The Examiner's Director also says the Examiner has failed to adequately "develop the issues involved." PETITION DECISION (22 May 2003). The Examiner's Director says, in substance, that after half a dozen OFFICE ACTIONS, the examiner has failed to do her job. Petitioner respectfully submits that the Examiner's alleged failure to do her job is not legal grounds to divest Petitioner of its Constitutional right to a patent.

## THE FOURTH APPEAL

Petitioner can understand why the Director is reluctant to have the Board review the Examiner's work. The Director's reluctance, however, is not grounds to bar the Petitioner's Constitutional right to a patent. Thus, in response to the Director's May 22<sup>nd</sup>, 2003 PETITION DECISION, Petitioner now asks the Court to intercede. In so doing, Petitioner has filed a fourth APPEAL BRIEF, included in the Appendix, addressing the points raised in the Examiner's latest OFFICE ACTION.

## THE REASONS WHY THE COURT SHOULD ISSUE THE WRIT

The Court can issue this writ because it has the legal power to do so. The Court should issue this writ because (i) the Supreme Court says that mandamus is an appropriate remedy in this situation, and (ii) the writ will protect the public interest.

## THE FEDERAL CIRCUIT CAN ISSUE THIS WRIT BECAUSE IT HAS THE LEGAL POWER TO DO SO

The Court of Appeals for the Federal Circuit not only has jurisdiction over this petition, the Federal Circuit is the only court with such jurisdiction.

### The Federal Circuit Has Jurisdiction

The Federal Circuit has jurisdiction to review mandamus requests. The Court of Customs & Patent Appeals discussed the Court's jurisdiction to issue mandamus to preserve an applicant's right to appeal in Margolis v. Banner, 599 F.2d 435 (C.C.P.A. 1979).

In Margolis, the examiner rejected the application, and the applicant appealed. In response, the examiner refused to forward the case to the Board of Appeals. Rather (as in the immediate case), the examiner simply issued another Office Action. The applicant petitioned

the Commissioner to reverse the examiner's action. Id. at 439. The Commissioner denied the petition. Id. The applicant then petitioned the C.C.P.A. for a writ of mandamus.

The Court first acknowledged that it lacked appellate jurisdiction to review certain administrative decisions of the Commissioner. The Court found, however, that "the court clearly has the power to issue writs under the All Writs Act in aid of its prospective appellate jurisdiction." Id. at 440-41. The Court found this jurisdiction extends to "action by the Commissioner or those acting under his authority that would frustrate such prospective appellate jurisdiction." Id. The Court expressly said that mandamus authority is not confined to the issuance of writs in aid of a jurisdiction already acquired by filing an appeal; rather the Court's jurisdiction extends to *any* case which is even *potentially* within its appellate jurisdiction. Id. Because the case at hand involved a patent application, the case fell clearly within the potential jurisdiction of the Court.

The Court said it was "particularly noteworthy" that a rejection had been made, but then withdrawn after applicant filed an APPEAL BRIEF. Id. at 442, n.20. The Court recognized that the examiner's "Withdrawal of the rejection, of course, frustrated the appeal." Id. The Court noted that the Commissioner's subsequent denial of the Petition, "precluding petitioners from an appeal to the Board of Appeals from the *de facto* rejection, clearly had the effect of frustrating this court's prospective appellate jurisdiction over an appeal from a decision of the Board of Appeals." Id.

The Court thus concluded that the Commissioner's refusal to forward the APPEAL BRIEF to the Board "prevented an appeal of the examiner's action to the Board of Appeals from whose decision an appeal might be taken to this court." Id. at 441. In so doing, the Commissioner denied the applicant his statutory right to appeal. The Court thus found

mandamus jurisdiction appropriate to preserve the Court's own prospective appellate jurisdiction.<sup>1</sup>

*The Federal Circuit Has Exclusive  
Jurisdiction Over This Petition*

The Commissioner has in the past argued that mandamus petitions should be heard by a District Court, rather than an appellate court. The C.C.P.A. has already reviewed this position - and rejected it. The C.C.P.A. said that requiring a District Court to issue the writ "is not consonant with the purposes of the All Writs Act, because it would place in another court the discretionary power to preserve the prospective appellate jurisdiction of this court. Margolis v. Banner, 599 F.2d 435, 443 (C.C.P.A. 1979). Therefore, the Federal Circuit, rather than a District Court, is the appropriate court to issue this writ.

For the forgoing reasons, the Court can issue the writ. In addition, the Court should issue the writ, because: (i) the Supreme Court says it is an appropriate remedy; and (ii) it protects the public interest.

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<sup>1</sup> See also Cook v. Dann, 522 F.2d 1276, 1276 (C.C.P.A. 1975) ("respondents' challenge to our jurisdiction under the All Writs Act (28 U.S.C. 1651(a)) must be rejected"); Weil v. Dann, 503 F.2d 562 (C.C.P.A. 1974); Duffy v. Tegtmeyer, 489 F.2d 745 (C.C.P.A. 1974); Loshbough v. Allen, 404 F.2d 1400 (C.C.P.A. 1969); Reddy v. Dann, 529 F. 1347, 1348 (C.C.P.A. 1976) ("our decisions in Duffy and Weil to deny writs were necessarily based on our first finding that we had jurisdiction to issue writs of mandamus").

THE COURT SHOULD ISSUE THIS WRIT  
BECAUSE IT IS THE APPROPRIATE  
REMEDY FOR THIS SITUATION

*Refusing To Hear An Appeal Is An Abuse  
Of Discretion. For Which The Proper  
Remedy Is A Writ Of Mandamus*

The Supreme Court says that where an examiner refuses to forward an APPEAL BRIEF for review, an appropriate remedy is a writ of mandamus. Steinmetz v. Allen, 192 U.S. 543 (1904).

In Steinmetz, the patent examiner issued a second rejection, and Steinmetz filed an appeal. The examiner, however, “refused to answer the appeal and to forward the same with his answer thereto” for review. Id. at 547. Steinmetz thus petitioned the Commissioner to forward the appeal for review. Id. The Commissioner denied the petition. Id.

The Supreme Court began by reasoning that a patent applicant is entitled to an appeal as a matter of right. Id. at 556. By refusing to forward the appeal for review, the Examiner divests the applicant of this statutory right. The Supreme Court noted that in this situation, if the applicant yields to the demands of the Examiner, the applicant waives his right to appeal, but if the applicant “does not yield he will not be heard at all, and may subsequently be regarded as having abandoned his application.” Id. The Supreme Court concluded that “[a] ruling having such effect must be considered as final and appealable.” Id. The Supreme Court thus concluded that the examiner’s refusal to forward the appeal is a decision ripe for court review.

The Supreme Court then turned to the merits of the case. The Supreme Court began by recognizing that the Commissioner has “some discretion” in administering the agency. Id. at 560. The Supreme Court noted, however, that “Some discretion is not an unlimited discretion.” Id. The Supreme Court said that refusing to hear an appeal is not within the

discretion of the Commissioner. To the contrary, it is the exact opposite - it is a refusal by the Commissioner to exercise any discretion at all. The Supreme Court said the Commissioner's refusal to adjudicate the appeal:

is not the exercise of discretion; it is a determination not to hear. No inventor can reach the point of invoking the discretion of the Patent Office. He is notified in advance that he will not be heard, no matter what he might be able to show. His right is denied, therefore; not regulated.

Id. at 560-61. The Supreme Court found that refusing to adjudicate the appeal "precludes the exercise of any judgment" by the Commissioner at all. Id. at 561. The Supreme Court thus concluded that the Commissioner's refusal to hear the appeal at all, no matter what the applicant might show, is outside the Commissioner's discretion.

Finding an abuse of discretion, the Supreme Court then addressed what kind of remedy is appropriate. The Supreme Court acknowledged that mandamus is an exceptional remedy. Id. at 563. The Court noted, however, that "if an appeal cannot be compelled from the decision of the primary examiner, an applicant is entirely without remedy." Id. at 564. The Supreme Court therefore held that the exceptional remedy of mandamus is appropriate here. Id. at 566.

The Supreme Court's lead has been followed repeatedly where the Commissioner refuses to adjudicate an applicant's appeal. For example, in Margolis v. Banner, 599 F.2d 435, 443 (C.C.P.A. 1979) (discussed above), the examiner raised a rejection, but then withdrew it after applicant filed an appeal. Id. at 442, n.20. The Court recognized that "Withdrawal of the rejection, of course, frustrated the appeal." Id. The Court noted the examiner's actions, "precluding petitioners from an appeal to the Board of Appeals ... clearly had the effect of frustrating this court's prospective appellate jurisdiction over an appeal from

a decision of the Board of Appeals.” The Court thus found a writ of mandamus an appropriate remedy “to secure this court’s eventual appellate jurisdiction.” *Id.* at 444.

Similarly, in Coe v. Remington Rand, Inc., 84 F.2d 240 (App.D.C. 1936), in response to the eighth (!) office action, the applicant filed an amendment. *Id.* at 241. The examiner, however, refused to consider it. The court noted that this refusal “did not amount to a rejection of the application, from which appeal might be taken to the proper court.” *Id.* at 242. The examiner’s refusal, however, effectively “blocked ... the right of appeal to the Board of Appeals ... so that petitioner was deprived of any right of appeal whatever for the determination of his rights.” *Id.* at 242. The court thus concluded that a writ of mandamus is an appropriate remedy.

*The Examiner’s Actions Are Both  
“Arbitrary” And “Capricious”*

In the immediate case, as in Steinmetz, Margolis, and Remington-Rand, the Examiner has blocked Petitioner’s right to appeal. In contrast to these cases, however, the Examiner in the immediate case has also, *inter alia*, (a) rejected claims based on references which do not qualify as prior art as a matter of law; (b) re-argued rejections previously conceded to be erroneous; (c) re-argued rejections based on “cumulative” art redundant to art previously conceded to not bar the claims; (d) issued contradictory factual findings; (e) refused to produce required evidentiary materials; and (f) willfully ignored express claim limitations. This behavior defines “arbitrary and capricious,” and is arguably even vindictive. It is perfectly clear why the examiner’s Director does not want the Board to review this file. Thus, the immediate case presents an even greater need for Court intervention than did Steinmetz.



Granting The Writ Assures Discipline  
In The Patent Prosecution Process

Granting the requested writ is good policy. The writ will prevent the examiner from forcing Petitioner to repeatedly argue the same issues. Forcing a patent applicant to repeatedly re-litigate the same issues is a "misallocation of resources" to be avoided. See Blonder-Tongue, Inc. v. Univ. of Illinois Foundation, 402 U.S. 313 (1971) (permitting a party to repeatedly re-litigate the same issue "reflects either the aura of [a] gaming table or 'lack of discipline and of disinterestedness'").

Here, the nature rejections raised in the ~~six~~ OFFICE ACTIONS in this case waste resources and, a cynic might say, even evidence "lack of discipline" or "lack of disinterestedness." The Court should not let the patent examination process degenerate into a "gaming table" of unfounded rejections. The Court can prevent this by issuing a writ of mandamus.

The Writ Will Prevent the Examiner  
From Violating PTO Rule 192

Filing an APPEAL BRIEF forces the examiner to hold an "appeal conference" with the examiner's supervisor and at least one other supervisory examiner. M.P.E.P. § 1208. The two supervisors review the propriety of the examiner's actions and may (as happened in the immediate case) conclude that the examiner's actions are not legally sustainable. Thus, Office procedure allows the examiner to ask the applicant to reopen prosecution.

Reopening prosecution, however, delays prosecution and hurts patent applicants. 62 Fed. Reg. 53170-71 (1997) ("any delay in prosecution resulting from the reopening of prosecution is to the detriment of the applicant."). To avoid this harm, 37 C.F.R. § 1.192 says the choice to reopen prosecution or reinstate the appeal is applicant's choice, not the

examiner's. Id. ("Thus, it is considered appropriate to give the applicant the choice of whether to prosecute the application before the examiner or reinstate the appeal")

In the immediate case, however, the examiner has consistently refused to even offer the Petitioner the choice of reinstating the appeal, unilaterally reopening prosecution in response to each appeal. *See* INTERVIEW SUMMARY (27 July 2001); OFFICE ACTION (20 Feb. 2003). Issuing the writ will prevent the examiner from continuing to ignore the Commissioner's own Rule 192.

*Issuing The Writ Will Protect  
The Petitioner And The Public*

Recall that the examiner's Director alleges that the examiner, in six OFFICE ACTIONS, has failed to develop the record. *See* PETITION DECISION (23 May 2003). The Commissioner may thus argue that the Commissioner should be allowed the opportunity to further develop the record. Petitioner agrees that given the potentially significant economic effect an issued patent has on the general public, it is in everyone's interest to assure that prosecution is done competently and disinterestedly.

Petitioner, however, believes it unwise to allow the examiner further time to "develop the record," because the factual record is complete and needs to be assessed disinterestedly.

*This Case Already Has An  
Encyclopedic Record Of Art*

The prosecution history already includes perhaps fifty patent and non-patent references. *See* APPEAL BRIEF page 2, n.1 (July, 2003). The Director does not allege any specific shortcoming in the existing factual record (*e.g.*, that the Examiner should have searched this-or-that field of prior art, but erroneously failed to do so). Thus, it appears undisputed that the factual record is complete.

The Record Of Art Needs To Be  
Assessed Disinterestedly And  
Competently

Using this encyclopedic record of art, the examiner has, in six OFFICE ACTIONS, failed to identify legally-competent reasons to bar the pending claims. Allowing the same examiner to issue an indeterminate number of additional OFFICE ACTIONS will not protect Petitioner's Constitutional right to a patent, nor protect the general public's interest in assuring that patents issue after a disinterested and competent examination.

In contrast, the public interest will be protected by enabling the Board to apply their expertise to this case. Thus, in granting the writ requested, the Court will protect the public interest by allowing the application to be examined by the Board.

For the forgoing reasons, the Court may issue a writ of mandamus. The Court may, alternatively, rule on the merits directly.

**THE REASONS WHY THE FEDERAL CIRCUIT  
SHOULD RULE ON THE MERITS**

At the turn of the century, where an examiner foreclosed an appeal, perhaps the only remedy was a writ of mandamus. See Steinmetz v. Allen, 192 U.S. 543, 564 (1904). Today, however, the 1952 Patent Act provides the Court with another power - the power to adjudicate the merits directly, pursuant to 35 U.S.C. § 141. Thus, as an alternative to mandamus, Petitioner asks the Federal Circuit to substantively rule on the merits of the application.

The Federal Circuit can do this because it has the legal power to do so. The Federal Circuit should this because the *factual record* in this case is fully developed, and the Court can reach its own *legal conclusions* unfettered by any deference to the Commissioner.

THE FEDERAL CIRCUIT HAS  
LEGAL POWER TO RULE ON  
THE MERITS OF THE CASE

Section 141 gives the Federal Circuit legal power to adjudicate the merits. Section 141 says "An applicant dissatisfied with the decision in an appeal to the Board of Patent Appeals ... may appeal the decision to the United States Court of Appeals for the Federal Circuit." This statute, then, gives the Federal Circuit power to review "the decision in an appeal."

Such a decision may, for example, be a decision by the Board. The statute on its face, however, is not limited to decisions by the Board. To the contrary, the statute broadly grants authority over any "decision." The statute does not distinguish between decisions by the Board or by other persons. Thus, the statute on its face gives the Court power to review *any* "decision in an appeal," regardless of whether that decision is rendered by the Board itself, or by the Commissioner, or by an examiner.<sup>2</sup>

In the immediate case, we have several "decisions in the appeal." First, the examiner decided to refuse to pass the appeal to the Board at all - thereby foreclosing the appeal. Second, the examiner decided to unilaterally reopen prosecution (violating 37 C.F.R. § 1.192) - thereby foreclosing the appeal. Third, the examiner's Director decided to not transfer the case to the Board - thereby foreclosing the appeal. Each one of these decisions terminates the appeal with finality. Any one of these three decisions should therefore be considered a "decision in an appeal" under Section 141.<sup>3</sup>

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<sup>2</sup> If the Court rules that Section 141 does, or does not, give the Court authority to rule on the merits of this case, then Petitioner (per Local Rule 47.6(c)) requests the Court publish its opinion as precedent, to provide guidance to the bar on this issue.

<sup>3</sup> As an aside, independently of 35 U.S.C. 141, the Administrative Procedure Act empowers the Court to intervene in an administrative process wherever the agency does not render its decision "within a reasonable time." In re Telecommunications Rsch. & Action Ctr., 750 F.2d 70 (D.D.C. 1984). Here, Petitioner requested

The Commissioner may argue that the intent of Section 141, if not its express language, is to grant legal authority to the Federal Circuit only for decisions by the Board itself. In other words, the Commissioner might argue that the statute should read "An applicant dissatisfied with the decision [by the Board] in an appeal to the Board."

This argument is contradicted by the plain language of the statute, which could easily have said this, but does not.

This argument also seems patently unfair. Remember, it is the *Commissioner* who has completely blocked the Board's ability to adjudicate the appeal. It is the *Commissioner* - not the Petitioner - who has completely prevented the Board from rendering any appealable decision. The Commissioner should thus not be heard to complain that the examiner's own (illegal) refusal to allow the Board to render a decision, strips the Federal Circuit of the power to review this case under Section 141.

#### THE FACTUAL RECORD IS FULLY DEVELOPED

The factual record for this case is fully-developed. While the examiner has asserted various (albeit contradictory) legal conclusions, these are accorded no deference at all.

#### *The Factual Record Is Complete*

The record for this case includes perhaps fifty patent and non-patent references, *see* APPEAL BRIEF page 2, n.1 (July, 2003), and perhaps half a dozen DECLARATIONS. In addition, the parties have each had ample opportunity to raise - and proffer evidentiary

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an appeal four times. The Commissioner refused four times. The Commissioner's refusal to render a decision at all, much less decide within a reasonable time, requires Court intervention. *Cf. id.*

support for - factual assertions not stated in the references. This factual record is adequate for the Court to render a decision.

In reviewing the factual record, however, the Court's scientific advisor should remain mindful to disregard factual assertions which were contested and not properly supported by competent evidence (*e.g.*, the examiner's refusal to respond to Petitioner's repeated requests for AFFIDAVITS OF REFERENCES). *E.g.*, In re Ahlert, 165 USPQ 418, 420 (C.C.P.A. 1970); In re Evnde, 178 USPQ 470, 474 (C.C.P.A. 1973); Ex parte Grochowski, No. 95-1343 at 5 (B.P.A.I., June 27, 1995); Ex parte Nouel, 158 USPQ 237 (B.P.A.I. 1967) (relying on a judicially-noticed fact to invalidate a claim is reversible error).

*The Examiner's Legal Conclusions  
Are Entitled To No Deference At All*

While the factual record is complete, for legal conclusions the Court has a rare opportunity to write on a *tabula rasa*.

The Court is aware that Patent Office conclusions of law which are supported by substantial evidence are entitled to some deference in suits under Administrative Procedure Act Section 706. Lehman v. Zurko, 525 U.S. 961 (1998). Deference is accorded because in an APA suit, "A new proceeding is instituted in the courts to set aside the conclusions reached by the administrative department." *Id.* at 159 (*quoting Morgan v. Daniels*, 153 U.S. 120 (1894)).

In the immediate case, however, the examiner's conclusions of law are entitled to no deference at all, for two reasons. First, the immediate case is not governed by APA Sec. 706, but by 35 U.S.C. § 141. Thus, any deference required under Zurko is inapposite.

Second, assuming the Court must accord some deference to "the conclusions reached by the administrative department," no deference is required here, for two reasons. First, the

Board has not reached any "conclusions" at all. To the contrary, the Examiner has foreclosed the Board from reviewing the case at all, much less reaching any conclusions. Second, the Examiner's own actions should be accorded no deference, because the Examiner's own Director argues that those actions are erroneous. See PETITION DECISION (22 May 2003).

Further "Development" Appears Futile

The examiner's Director says that because the examiner has not done her job, the record needs further "development." See PETITION DECISION (22 May 2003). Regarding the examiner's legal conclusions, Petitioner agrees with the Director that the Examiner has not, despite six attempts, succeeded in articulating a *prima facie* case for unpatentability. The examiner's inability to do so, however, does not mean the case requires "further development" - it means the exact opposite - it means that the Examiner *should have allowed the case a long time ago*.

SUMMARY

Enclosed find copies of several of the cited authorities, and a Local Rule 30(a)(3)(A) Appendix. The Appendix includes hard copies of the 20 Feb. 03 OFFICE ACTION and the 16 July 2003 APPEAL BRIEF. The Appendix also includes a copy of the entire prosecution history (including all references of record), as an Adobe Acrobat® file on CD-ROM.

Respectfully submitted as of 16 July 2003 on behalf of Petitioner by its attorneys,

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Enclosures:

Steinmetz v. Allen, 192 U.S. 543 (1904)  
Overland Motor Co. v. Packard Motor Co., 274 U.S. 417 (1927)  
Margolis v. Banner, 599 F.2d 435 (C.C.P.A. 1979)

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**LOCAL RULE 30(A)(3)(A) APPENDIX**

20 Feb. 03 OFFICE ACTION

16 July 2003 APPEAL BRIEF

CD-ROM

**H**

Supreme Court of the United States

UNITED STATES *ex rel.* CHARLES P. STEINMETZ, *Plff.*  
*in Err.*,

v.

FREDERICK I. ALLEN, Commissioner of Patents.

No. 383.

Argued January 12, 13, 1904.

Decided February 23, 1904.

IN ERROR to the Court of Appeals of the District of Columbia to review a judgment which affirmed the judgment of the Supreme Court of that District dismissing a petition for mandamus to compel a Commissioner of Patents to require the primary examiner to forward an appeal to the board of examiners-in-chief. *Reversed*, with directions to reverse the judgment of the Supreme Court, and to direct that court to grant the writ of mandamus.

See same case below, 31 Wash. L. Rep. 358.

West Headnotes

**Mandamus** ➡86

250k86 Most Cited Cases

Mandamus lies to compel the Commissioner of Patents to require the primary examiner to forward to the board of examiners in chief the appeal to which an inventor is entitled, under Rev.St.U.S. § 4909, 35 U.S.C.A. § 57, upon a second rejection of any of his claims by the primary examiner, where such examiner has twice denied his right to unite in one application process and apparatus claims which are essentially the same invention.

**Federal Courts** ➡491

170Bk491 Most Cited Cases

(Formerly 106k388)

A suit in which the validity of a regulation established by the Commissioners of Patents, under the authority of Rev.St.U.S. § 482, 35 U.S.C.A. § 7, for the conduct of proceedings in the Patent Office, is assailed, is one in which there is drawn in question the validity of "an authority exercised under the United States" within the meaning of Act Feb. 9, 1893, c. 74, § 8. 27 Stat. 436 giving an appeal in such cases from the final judgment or decree of the Court of Appeals of the District of Columbia to the federal Supreme Court.

**Patents** ➡98

291k98 Most Cited Cases

So far as rule 41 of the Patent Office rules of practice prevents an inventor from uniting in one application process and apparatus claims which are essentially the same invention, it is invalid as an abuse of the discretion vested in the Patent Office to permit or deny a joinder of inventions.

**Patents** ➡107

291k107 Most Cited Cases

An inventor is not estopped from insisting upon his application for a patent in which were united process and apparatus claims for essentially the same invention by requiring his process claims to be placed in interference with those of an existing patent after receiving a letter from the primary examiner permitting the retention of the process and apparatus claims pending the determination of the interference, but stating that the acceptance of an interference on one of the process claims would be held by the office to be an election of the prosecution of such claims, and further prosecution of the apparatus claims would not be permitted.

**\*\*419 \*549 Messrs. Frederick h. Betts and Melville Church** for plaintiff in error.

**\*553 Assistant Attorney General McReynolds, Solicitor General Hoyt, and Mr. John M. Coit** for defendant in error.

**\*\*417 Statement by Mr. Justice McKenna:**

**\*543** This is a petition in mandamus filed in the supreme court of the District of Columbia to compel the Commissioner of **\*544 Patents** to require the primary examiner to forward an appeal, prayed by the petitioner, to the board of examiners-in-chief, to review the ruling of the primary examiner requiring petitioner to cancel certain of his claims in his application for motor meters.

The supreme court dismissed the petition, and its action was affirmed by the court of appeals. This writ of error was then sued out.

The decision of the primary examiner was based upon rule 41 of practice in the Patent Office, and the case involves the validity of the rule under the patent laws.

The petitioner filed an application in the Patent Office, November 21, 1896, for a patent for 'certain new and useful improvements in motor meters.' He expressed his invention in thirteen claims. They are inserted in the margin. [FN<<dagger>>]

**\*\*418 \*545** The first six were held by the primary examiner to be claims for a process; the balance of the claims to be for an apparatus; and on the 15th of May, 1900, ordered that the latter, that is, claims 7, 8, 9, 10, 11, 12, and 13, be canceled

from the application. In other words, he required a division between the process claims and the apparatus claims, in accordance with rule 41. That rule is as follows:

**\*546** '41. Two or more independent inventions cannot be claimed in one application; but where several distinct inventions are dependent upon each other and mutually contribute to produce a single result, they may be claimed in one application.

'Claims for a machine and its product must be presented in separate applications.

'Claims for a machine and the process in the performance of **\*547** which the machine is used must be presented in separate applications.

'Claims for a process and its product may be presented in the same application.'

Petitioner persisted in his application as filed, and the primary examiner repeated his order for a division of the claims. Petitioner regarded such order as 'a second final rejection' of his claims to the apparatus, and appealed therefrom to the board of examiners-in-chief. The primary examiner refused to answer the appeal and to forward the same with his answer thereto and the statements required by the rules of the Patent Office. Thereafter, on the 20th of August, 1900, petitioner petitioned the Commissioner of Patents to direct the primary examiner to forward said appeal, which petition was denied. It was repeated to the present Commissioner, defendant in error, **\*\*419** and by him denied on the 7th of February, 1902.

These facts constitute petitioner's claim to relief.

The answer of the respondent asserts the validity of rule 41, justifies the action of the Patent Office, alleges that petitioner is estopped from contesting the orders of the primary examiner, and also alleges that those orders 'did not involve the rejection of any claim or an action upon the merits of any claim made by the relator,' as provided in rule 13, and that 'the statutes and rule 133 of the rules of practice do not provide for an appeal to the examiners-in-chief from an examiner's requirement for division, and the examiners-in-chief have no jurisdiction to pass upon the question whether or not division should be required.'

The answer presents also the following facts: Prior to making the order of May 15, 1900, to wit, on October 9, 1899, the primary examiner wrote a letter to petitioner regarding the division of the process claims and the apparatus claims, in accordance with rule 41, before further action would be given upon the merits of the case.

Petitioner replied December 15, 1899, requesting 'that the

**\*548** requirement for division be waived for the present,' in order that his process claims be placed in interference with the claims of a patent to one Duncan. To this request the examiner answered:

'Pending the determination of the interference, applicant may retain the method and apparatus claims in this case, but the acceptance of an interference on one of the method claims will be held by the office to be an election of the prosecution of the method claims, and the further prosecution of the apparatus claims in this application will not be permitted.'

Petitioner replied January 19, 1900, urging that the interference be declared, and on February 7, 1900, it was declared and decided in favor of petitioner. After the decision the examiner wrote the letter of May 15, 1900. These proceedings, respondent contends, constitute an estoppel.

The first ruling of the Commissioner of Patents upon the petition to require the primary examiner to respond to petitioner's appeal was as follows:

'Where applicant does not care to comply with the examiner's requirements in a matter of division such as is here involved, it has been the practice for the past thirty years to treat the question, not as one of merits, and appealable to the examiners-in-chief, but as a proper matter for petition to the Commissioner. I see no reason for overturning this practice. This petition is denied.'

The second order of the Commissioner, respondent, after reciting certain of the facts, concluded as follows:

'The requirement for division is purely a matter of form, not involving the merits of the claims, since the claims may be, and in the present case are, regarded as allowable. The examiner has not refused to grant a patent to this applicant upon any of the claims presented, but has merely required that they be included in two patents instead of one. It is a question of procedure, or of the manner of securing the protection, which is in controversy, and not the right of the applicant to a patent upon any of the claims presented.

**\*549** 'The examiner was right in taking the position that the question involved is not appealable to the examiners-in-chief, and although it is a general rule of law that the appellate tribunal is the one to determine whether or not it has jurisdiction when an appeal is taken to it, it is not considered necessary in the office practice to follow that practice strictly, since the Commissioner is the head of the office and has the final decision upon all questions arising within it and may settle questions of this kind upon direct petition. The examiner's decision upon the question whether or not an appeal to the examiners-in-chief is regular and

proper is not final, since it may be reviewed by the Commissioner upon petition, but he has authority to pass upon that question in the first instance.

'The petition is denied.'

**\*555** Mr. Justice McKenna, after stating the case as above, delivered the opinion of the court:

1. The jurisdiction of this court to review the judgment of the court of appeals is questioned. There is no money in dispute nor anything to which a pecuniary value has been given. Jurisdiction is claimed under the clause of § 8 of the act of February 9, 1893 [27 Stat. at L. 436, chap. 74 U. S. Comp. Stat. 1901, p. 573], which gives an appeal to this court from the final judgment or decree of the court of appeals in cases in **\*556** which there is drawn in question the validity of 'an authority exercised under the United States.'

By § 483 of the Revised Statutes (U. S. Comp. Stat. 1901, p. 272), the Commissioner of Patents, subject to the approval of the Secretary of the Interior, is empowered to establish from time to time regulations not inconsistent with law, for the conduct of **\*\*420** proceedings in the Patent Office. The Commissioner of Patents, exercising the power conferred, established, among other rules of practice, rule 41. It thereby became a rule of procedure, and constituted, in part, the powers of the primary examiner and Commissioner. In other words, it became an authority to those officers, and, necessarily, an authority 'under the United States.' Its validity was and is assailed by the plaintiff in error. We think, therefore, we have jurisdiction, and the motion to dismiss is denied.

2. The issue is well defined between the parties, both as to the right and remedy, in the Patent Office. As to right, petitioner contends that a union by an inventor of process and apparatus claims, which are essentially the same invention, is given by the patent laws, and that rule 41, so far as it takes that right away, is repugnant to those laws, and invalid. As to remedy, that the decision of the primary examiner constituted a final decision upon the case, and petitioner was entitled to an appeal under the patent laws to the board of examiners-in-chief. The latter proposition depends upon the first. Assuming the right in an inventor as expressed in the first proposition, the primary examiner denied the right. True, a distinction can be made between his ruling and one on the merits, if we regard the merits to mean invention, novelty, or the like. But in what situation would an applicant for a patent be? If he yield to the rule he gives up his right of joinder. If he does not yield he will not be heard at all, and may subsequently be regarded as having abandoned his application. Section 4894, Rev. Stat. (U. S. Comp. Stat. 1901, p. 3384). A ruling having such effect must be considered as final and appealable. Whether,

however, to the examiners-in-chief or to the Commissioner, and **\*557** from the latter to the courts, we may postpone answering until we have considered the right of an inventor to join process and apparatus claims in one application.

Section 4886 of the Revised Statutes of the United States (U. S. Comp. Stat. 1901, p. 3382), provides as follows:

'Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, not known or used by others in this country before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country before his invention or discovery thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor.'

There is nothing in the language of the section which necessarily precludes the joinder of two or more inventions in the same application. But the section does distinguish inventions into arts (processes), machines, manufactures, and compositions of matter, and the earliest construction of the law denied the right of joinder. An exception, however, came to be made in cases of dependent and related inventions.

In *Hogg v. Emerson*, 6 How. 437, 12 L. ed. 505, it was said:

'The next objection is, that this description in the letters thus considered covers more than one patent and is therefore void.

'There seems to have been no good reason at first unless it be a fiscal one on the part of the government when issuing patents, why more than one in favor of the same inventor should not be embraced in one instrument, like more than one tract of land in one deed or patent for land. Phillips, Patents, 217.

'Each could be set out in separate articles or paragraphs, as different counts for different matters in libels in admiralty or declarations at common law, and the specifications could be made distinct for each, and equally clear.

'But to obtain more revenue, the public officers have generally **\*558** declined to issue letters for more than one patent described in them. Renouard, Desbrevets D'Invention, 293; Phillips, Patents, 218. The courts have been disposed to acquiesce in the practice as conducive to clearness and certainty. And if letters issue otherwise inadvertently, to hold them, as a general rule, null. But it is a well established exception that patents may be united, if two

or more, included in one set of letters, relate to a like subject, or are, in their nature or operation, connected together. Phillips Patents, 218, 219; *Barrett v. Hall*, 1 Mason, 447, Fed. Cas. No. 1,047; *Moody v. Fiske*, 2 Mason, 112, Fed. Cas. No. 9,745; *Wyeth v. Stone*, 1 Story, 273, Fed. Cas. No. 18,107.'

This language would seem to imply that not the statute, but the practice of the Patent Office, required separate applications for inventions, but the cases cited were explicit of the meaning of the statute. Mr. Justice Story, in *Wyeth v. Stone*, said:

'For, if different inventions might be joined in the same patent for entirely different purposes and objects, the patentee would be at liberty to join as many as he might choose, at his own mere pleasure, in one patent, which seems to be inconsistent with the language of the patent acts, which speak of the thing patented, and not of the things \*\*421 patented, and of a patent for invention, and not of a patent for inventions; and they direct a specific sum to be paid for each patent.'

But he confined the requirement to independent inventions, and his illustrations indicated that he meant by independent inventions not those which, though distinct, were 'for the same common purpose and auxiliary to the same common end.'

*Hogg v. Emerson* came to this court again and is reported in 11 How. 587, 13 L. ed. 824. Of one of the objections to the patent the court said:

'It is that the improvement thus described is for more than one invention, and that one set of letters patent for more than one invention is not tolerated by law.'

'But grant that such is the result when two or more inventions are entirely separate and independent,--though this is doubtful on principle,--yet it is well settled, in the cases formerly cited, that a patent for more than one invention is not void if \*559 they are connected in their design and operation. This last is clearly the case here.'

Many other cases are to the same effect.

Can it be said that a process and an apparatus are inevitably so independent as never to be 'connected in their design and operation?' They may be completely independent. *Cochrane v. Deener*, 94 U. S. 780, 24 L. ed. 139. But they may be related. They may approach each other so nearly that it will be difficult to distinguish the process from the function of the apparatus. In such case the apparatus would be the dominant thing. But the dominance may be reversed and the process carry an exclusive right, no matter what apparatus may be devised to perform it. There is an illustration in the

*Telephone Cases*, 126 U. S. 1, 31 L. ed. 863, 8 Sup. Ct. Rep. 778. The claim passed upon in those cases was as follows:

'The method of, and apparatus for, transmitting vocal or other sounds telegraphically, as herein described, by causing electrical undulations, similar in form to the vibrations of the air accompanying the said vocal or other sounds, substantially as set forth.'

The claim was held to refer to the art described, and the means of making it useful. The court observed:

'Other inventors may compete with him for the ways of giving effect to the discovery, but the new art he has found will belong to him and those claiming under him during the life of his patent.'

A distinction between the process and the means employed for using it was recognized. It was said:

'The patent for the art does not necessarily involve a patent for the particular means employed for using it. Indeed, the mention of any means, in the specification or descriptive portion of the patent, is only necessary to show that the art can be used; for it is only useful arts--arts which may be used to advantage--that can be made the subject of a patent.'

The patent was sustained. It was not attacked because it embraced independent inventions. The fact is not without \*560 force. Considering the ability of counsel engaged and the division of the court in opinion, it is a proper inference that no tenable objection to the patent was overlooked.

It is said by Robinson, in his work on Patents, that 'special rules which govern the joinder of arts or processes with each other or with related inventions of a different class, are more stringent in the Patent Office than in the courts.' 2 Robinson, Patents, § 473. And the author deduces the conclusion that under the rules of the Patent Office a process cannot be 'joined with the apparatus that performs it, nor either of these with the product in which they result, unless they are to such an extent inseparable that the existence of some one of them is dependent upon that of the others.' But rule 41 precludes even this.

If there is a divergence of views between the courts and the Patent Office, and the divergence proceeds from a different interpretation of the statute, the views of the courts ought to prevail. If the courts, however, have only recognized and enforced the exercise of a discretion of the Patent Office, the question occurs, What is the extent of such discretion, and can it be expressed and fixed in an inflexible rule such as rule 41? In *Bennet v. Fowler*, 8 Wall. 445, 19 L. ed. 431, a discretion in the Patent Office was recognized. The question arose upon the validity of two reissued patents for improvements, which 'had been embraced in one, in the

original patent.' The court said:

'It may be that if the improvements set forth in both specifications had been incorporated into one patent, the patentee taking care to protect himself as to all his improvements by proper and several claims, it would have been sufficient. It is difficult, perhaps impossible, to lay down any general rule by which to determine when a given invention or improvements shall be embraced in one, two, or more patents. Some discretion must necessarily be left on this subject to the head of the Patent Office. It is often a nice and perplexing question.'

Some discretion is not an unlimited discretion, and if the \*561 discretion be not unlimited it is reviewable. In other words, the statute gives the right to join inventions in one application in cases where the inventions are related, and it cannot be denied \*\*422 by a hard and fixed rule which prevents such joinder in all cases. Such a rule is not the exercise of discretion; it is a determination not to hear. No inventor can reach the point of invoking the discretion of the Patent Office. He is notified in advance that he will not be heard, no matter what he might be able to show. His right is denied, therefore; not regulated. Such is the necessary effect of rule 41, as amended.

Without that rule the action of the Patent Office can be accommodated to the character of inventions, and discretion can be exercised, and when exercised, we may say in passing, except in cases of clear abuse, the courts will not review it. But the rule as amended, as we have said, precludes the exercise of any judgment, and compels the separation of claims for a process and claims for its apparatus, however related or connected they may be. And the right denied is substantial. Counsel for petitioner have explained that right by the embarrassments caused by its denial, one of which is that, by disclosing the apparatus in his application for the process, he might lose the right to and a patent for the apparatus; and to sustain that view *James v. Campbell*, 104 U. S. 356, 26 L. ed. 786, is cited. We are not prepared to admit such consequences nor that *James v. Campbell* so decides. If the classification of the statute makes a distinction between the different kinds of inventions--between a process and an apparatus--and requires or permits a separate application for each, it would seem to follow irresistibly that an application and patent for one would not preclude an application and patent for the other, and the order of the application could not affect the right which the law confers. *James v. Campbell* was a case of reissued patent, and by express provision of the statute as to reissued patents no new matter can be introduced in them. In other words, the reissue is to perfect, not to enlarge, the prior patent. Whether the principle of the case applies to \*562 related as well as to independent inventions is not clear from its language. The court said:

'Where a new process produces a new substance, the invention of the process is the same as the invention of the substance, and a patent for the one may be reissued so as to include both, as was done in the case of Goodyear's vulcanized rubber patent. But a process, and a machine for applying the process are not necessarily one and the same invention.'

The facts of the case did not call for a more definite ruling. The original patent was for a device for postmarking and canceling postage stamps by a single blow. The reissued patent claimed the act of marking and cancelation, and it was observed by the court:

'The process or act of making a postmark and canceling a postage stamp by a single blow or operation, as a subject of invention, is a totally different thing in the patent law from a stamp constructed for performing that process.'

But without attempting to enlarge the case and extend it to more intimately related inventions, it is enough now to say that there is nothing in the case which decides that if the process had been claimed in an independent application it (the process) would have been adjudged to have been dedicated to the public by the other patent. There is language indicating the contrary. It was said:

'If he [the patentee] was the author of any other invention than that which he specifically describes and claims, though he might have asked to have it patented at the same time and in the same patent, yet if he has not done so, and afterwards desires to secure it, he is bound to make a new and distinct application for that purpose, and make it the subject of a new and different patent.'

The case, however, indicates what embarrassment and peril of rights may be caused by a hard and fixed rule regarding the separation of related inventions. See also *Mosler Safe & Lock Co. v. Mosler*, 127 U. S. 354, 32 L. ed. 182, 8 Sup. Ct. Rep. 1148, and *Miller v. Eagle Mfg. Co.* 151 U. S. 186, 38 L. ed. 121, 14 Sup. Ct. Rep. 310.

\*563 The Patent Office has not been consistent in its views in regard to the division of inventions. At times convenience of administration has seemed to be of greatest concern; at other times more anxiety has been shown for the rights of inventors. The policy of the office has been denominated that of 'battledore and shuttlecock,' and rule 41 as it now exists was enacted to give simplicity and uniformity to the practice of the office. Its enactment was attempted to be justified by the assumption that the patent laws gave to the office a discretion to permit or deny a joinder of inventions. But, as we have already said, to establish a rule applicable to all cases is not to exercise discretion. Such a rule ignores the differences which invoke discretion, and which can alone justify its exercise, and we are of opinion therefore

that rule 41 is an invalid regulation.

3. Having settled the right of appellant, we may now return to the consideration of his remedy. Respondent contends:

'It is fundamental that mandamus will not issue against a public officer, except to compel the performance of some plain, \*\*423 clear, ministerial duty, and will not issue to control his discretion.'

And it is further contended that respondent has acted, and, having acted, cannot be required to refer the case to a lower tribunal in his office. To sustain the contention *Holloway v. Whiteley*, 4 Wall. 522, 18 L. ed. 335, is cited.

The unity of the inventions claimed by petitioner in the case at bar we may assume. It is not denied by respondent. Petitioner had, therefore, the right to join them in one application. The denial of this right by the primary examiner was a rejection of the application and entitled petitioner to an appeal to the examiners-in-chief, under § 4909 of the Revised Statutes (U. S. Comp. Stat. 1901, p. 3390). That sections provides:

'Every applicant for a patent, . . . any of the claims of which have been twice rejected. . . may appeal from the decision of the primary examiner to the board of examiners-in-chief; . . .'

\*564 The § 482 (U. S. Comp. Stat. 1901, p. 272), provides:

'The examiners-in-chief shall be persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the appellant, to revise and determine upon the validity of the adverse decisions of examiners upon applications for patents, and for reissues of patents, and in interference cases; and, when required by the Commissioner, they shall hear and report upon claims for extensions, and perform such other like duties as he may assign them.'

The procedure on appeal is provided for by the rules of the Patent Office. It is taken by filing a petition praying an appeal with the primary examiner, setting forth the reasons upon which the appeal is based, and it is made the duty of the examiner, five days before the date of hearing, to furnish the appellate tribunal and the appellant with a statement of the grounds of his decision. A petition praying an appeal was filed, but the primary examiner refused to answer the appeal, and the defendant in error also refused to direct him to answer it. It is manifest that if an appeal cannot be compelled from the decision of the primary examiner, an applicant is entirely without remedy. And respondent has asserted that extreme. In *Ex parte Frasch*, 20 App. D. C. 298, the court of appeals of the District of Columbia was persuaded that an appeal was not the proper remedy. In the

case at bar it is contended that mandamus is not the proper one. One or the other must be. A suggestion made is that the inventor must await a decision on the merits, meaning by merits 'lack of invention, novelty, or utility,' as expressed in rule 133. But after waiting he would encounter the arbitrary requirement of rule 41. Besides, what would there be to review if the order of the primary examiner were complied with and the claims put into separate applications? There are some observations in *Holloway v. Whiteley*, which may be quoted. Whitely claimed to be the assignee of a patent, and filed an application for a reissue. The Commissioner declined to entertain it on the ground that Whitely was only assignee of an interest, and not of the entire patent. He also \*565 declined to allow an appeal to be taken from his decision. The supreme court of the District of Columbia awarded a peremptory writ of mandamus commanding the Commissioner to refer the application to the proper examiner, or otherwise examine or cause it to be examined according to law. Error was prosecuted to this court. Under the act of 1836 [5 Stat. at L. p. 117, chap. 357], it was provided that if the Commissioner decided adversely to an applicant for a patent an appeal could be taken to the board of examiners, and by the act of 1837 [5 Stat. at L. 191, chap. 45], that remedy was given to an applicant for a reissue of a patent, and the question in the case was whether that remedy should have been pursued. In other words, whether the remedy was by appeal or mandamus. It was decided that appeal was the remedy. Singularly enough, the Commissioner, in answer to the rule, took the position that the application was not before him because it had not been filed. The court said if that were so 'mandamus would clearly lie to compel the Commissioner to receive it. It was his first duty to receive the application, whatever he might do subsequently. Without this initial step there could be no examination, and, indeed, no rightful knowledge of the subject on his part. Examination and the exercise of judgment, with their proper fruit, were to follow, and they did follow.'

And so the exercise of judgment might follow a hearing of the application under review. It was the duty of the primary examiner to accord a hearing or, refusing to do so, to grant an appeal. It was the duty of the Commissioner to compel the appeal. The Commissioner of Patents is primarily charged with granting and issuing patents. Applications for patents are made to him (§ 4888, Revised Statutes, U. S. Comp. Stat. 1901, p. 3383), and his superintendence should be exercised to secure the rights which the statutes confer on inventors. The first of those rights is a hearing. If that be denied other rights cannot accrue.

The Commissioner justifies his decision by the rules of the Patent Office and a long practice under them. If there is inconsistency between the rules and statute, the latter \*\*424 must prevail. \*566 But the primary examiner did not follow

the rules. The rules provide that if appeal be regular *in form* (italics ours) he shall, within five days of the filing thereof, furnish the examiners-in-chief with a written statement of the grounds of his decision on all of the points involved in the appeal, with copies of the rejected claims and with the references applicable thereto. If he decide that the appeal is not regular in form, a petition from such decision may be made directly to the Commissioner. The regularity of the appeal in form is not questioned in the case at bar, and it was the duty of the examiner to answer the appeal by furnishing the examiners-in-chief the statement provided for in rule 135. A petition to the Commissioner was not necessary except to make the examiner to perform his duty.

4. We do not think that petitioner was estopped from insisting upon his application by proceeding with the interference with Duncan after the examiner's letter of December 15, 1899. It would be pressing mere order of procedure and the convenience of the Patent Office too far to give them such result under the circumstances.

*The judgment of the Court of Appeals is therefore reversed, with directions to reverse that of the Supreme Court, and direct the Supreme Court to grant the writ of mandamus as prayed for.*

FN<<dagger>> 1. The herein-described method of measuring alternating electric currents, which consists in setting up or establishing a shifting field of magnetism from three intersecting lines or axes of magnetism and adapted to actuate a rotatable armature in a motor meter arranged within the energizing coils producing said lines of magnetization.

2. The herein-described method of actuating an alternating-current motor meter, which consists in setting up or establishing a shifting field of magnetism from three intersecting lines or axes of magnetization, and adapted to actuate a rotatable armature arranged within the energizing coils producing said lines of magnetization.

3. The herein-described method of actuating a single-phase alternating-current motor meter, which consists in setting up or establishing a shifting field of magnetism from three intersecting lines or axes of magnetization and adapted to actuate a rotatable armature arranged within the energizing coils producing said lines of magnetization.

4. The herein-described method of actuating an alternating-current motor meter, which consists in setting up or establishing a shifting field of magnetism by means of magneto-motive forces acting along three intersecting lines and subjecting an armature to the inductive action of said field.

5. The herein-described method of actuating an alternating-current motor meter, which consists in setting up or establishing a shifting field of magnetism by means of magneto-motive forces being proportional to the current and the other two to the electro-motive force, and subjecting an armature to the inductive action of said field.

6. The herein-described method of actuating an alternating-current motor meter which consists in setting up or establishing a shifting field of magnetism by means of magneto-motive forces acting along three intersecting lines, one magneto-motive force being proportional to the current and the other two to the electro-motive force, the several magneto-motive forces being so proportioned and related to each other that the resultant of the last two is displaced in phase from the first by the complement of the angle of lag, and subjecting an armature to the inductive action of said field.

7. In a Watt meter for alternating electric currents, means for producing a magnetic flux proportional to the current and varying in phase therewith, means for producing a second magnetic flux proportional to the electromotive force and lagging in phase behind the same, and means for producing an auxiliary flux along a line at an angle to said second flux, and of such magnitude and phase that the resultant of the two last-mentioned fluxes will lag behind the first by the complement of the angle of lag.

8. The combination in an electro motor of a field-magnet system and means for inducing therein magnetic fluxes of three phases, one a flux due to a series coil and proportional to the current, a second flux due to a shunt potential coil and lagging behind the electro-motive force, and a third flux lagging behind said second flux and having a fixed angular relation thereto such that the resultant of the second and third fluxes is dephased by substantially the complement of the angle of lag from the flux due to the series coil.

9. The combination in a recording electric meter of a field-magnet system acting on the armature and having a plurality of intersecting magnetic axes, means for inducing along one of said magnetic axes a flux proportional to the current and varying in phase therewith, and means for inducing along the other magnetic axes a plurality of other fluxes dependent upon the potential of the metered circuit, which lag behind the electro-motive force by different amounts and act upon the armature at different points, said fluxes being so proportioned in value and phase that their joint action upon the armature will enable the meter to register the true



energy consumed in an alternating-current circuit without being substantially affected by changes of phase relation.

10. In a Watt meter for alternating currents, the combination of a field-magnet system having three intersecting magnetic axes, means for producing along one of said axes a magnetic flux proportional to the current and varying in phase therewith means for producing along another of said axes an alternating flux proportional to the electro-motive force and lagging behind the same, and means for producing along the third axis an auxiliary magnetic flux also proportional to the electro-motive force, of such a magnitude and phase that the joint action of the several fluxes upon the armature will enable the meter to register the true energy consumed in an alternating-current circuit without being substantially affected by changes of phase relation.

11. In a meter for alternating currents, the combination of a field-magnet system having three intersecting magnetic axes, means for producing along one of said axes a magnetic flux proportional to the current and varying in phase therewith, means for producing along another of said axes an alternating flux proportional to the electro-motive force and lagging behind the same, and means for producing along the third axes an auxiliary magnetic flux also proportional to the electro-motive force and of such magnitude and phase that the joint action of the two potential fluxes upon the armature will produce a torque sufficient to overcome the static friction of the meter.

12. In a single-phase alternating current meter, the combination of a field-magnet system having three intersecting magnetic axes, a field coil in which the current phase varies as the conditions of the circuit change, producing a magnetization along one magnetic axis, a potential coil producing a magnetization along another magnetic axis, a reactance device in series with said potential coil for lagging the current behind the electro-motive force, and a second potential coil depending for its current upon the first potential coil, producing a magnetization along the third magnetic axis; the two potential coils conveying currents which differ in phase from each other, and each generating a flux which acts upon the armature at a point removed from the point at which the flux due to the other potential coil acts upon the armature.

13. In an electric meter, the combination of a multipolar field-magnet structure having three magnetic axes, current coils mounted upon some of the field poles and producing a magnetization

along one of said magnetic axes, potential coils mounted upon other field poles and producing a magnetization along another one of said magnetic axes, and other potential coils mounted upon a portion only of the lastnamed field poles, or some of them, and producing a magnetization along the third magnetic axis, and an armature acted upon by the flux induced by the field coils.

24 S.Ct. 416, 192 U.S. 543, 48 L.Ed. 555

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countersign the same. *Kendall v. United States*, 12 Pet. 524; *Wright v. Ynchausti*, 272 U. S. 640, 651, 652.

No matter what the power of the Auditor may prove to be with reference to the settlement of accounts as between the City of Manila and the Metropolitan Water Board, or what his power with reference to enforcing the settlement so reached by him, nothing in the laws of the Islands is disclosed to us which enables the Auditor in the enforcement of such settlements to dispense with or to suspend the operation of positive law in reference to the course which shall be followed in the disposition by the Internal Revenue Collector of the receipts from internal revenue collections which he is directed by the statute to pay to the City. His duty is clearly set forth and he has nothing to do but to comply with it, having ascertained exactly what the share of the City is under the foregoing provisions.

When this share comes to the City under the warrant to be drawn in its favor by the Collector, the question of what shall thereafter be done in respect to it is not a matter that we are called upon to consider. Whether the issue between the Metropolitan Water Board and the City of Manila, in the absence of agreement, is one that must then be decided by a suit in court brought by the Metropolitan Water Board against the City, asking for a judgment for the water used, or whether the issue is to be determined by the Insular Auditor in his asserted power of settling and enforcing accounts between the two branches of the Government, are issues not before us. The only question here is what should be done with the share of the collections made by the Internal Revenue Collector under the sections of the Administrative Code already quoted. By § 2442 of the Laws of the Philippines relating to the City of Manila, there is a provision for a permanent continuing appropriation during the time the City remains the capital of the Islands from any

funds in the Insular Treasury, not otherwise appropriated, equal to 30 per cent. of the expenses of the City government, within certain other limitations, and the Insular Auditor is to ascertain the amount thus appropriated and transfer it to the City. How far this would involve quasi-judicial or administrative discretion not to be controlled by mandamus, it is not necessary for us to consider or decide; because this case relates only to internal revenue receipts and their distribution, in respect of which the provisions of law are specific and mandatory as we have seen. The conclusion of the Supreme Court of the Philippines in directing a mandamus to issue against the Internal Revenue Collector and the Insular Auditor was in accordance with the statutory law of the Philippines and was right.

A majority of the Supreme Court of the Philippines reached this conclusion. That Court further expressed an opinion as to the relation of the City to the Insular Auditor and his functions, which was not necessary, it seems to us, to decide this case. We desire therefore to limit our opinion to the mere question whether the City's share of the internal revenue collections must be paid to the City by the Collector.

The judgment of the Supreme Court of the Philippines is

*Affirmed.*

OVERLAND MOTOR COMPANY v. PACKARD  
MOTOR COMPANY ET AL.

CERTIFICATE FROM THE CIRCUIT COURT OF APPEALS FOR THE  
SEVENTH CIRCUIT.

No. 285. Argued April 21, 1927.—Decided May 31, 1927.

1. An applicant for patent who cancels one of his claims without appealing, after a ruling finally rejecting it as unpatentable, announcing at the time his intention to file a divisional application

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covering the same subject matter, does not abandon it nor estop himself from so renewing it with the consent of the Patent Office. P. 420.

2. Granting of patent upon such new application imports a waiver by the Office of objection based on the previous rejection. P. 421.
3. A bill to enjoin infringement of a patent can not be dismissed upon the ground of laches because the pendency of the application in the Patent Office was protracted by the applicant's delays in responding to Patent Office action, where such delays in no instance exceeded the period allowed by statute. Rev. Stats. § 4894. P. 422.

RESPONSE to questions certified by the Circuit Court of Appeals upon an appeal from a decree enjoining alleged infringements of a patent.

*Mr. Melville Church, with whom Mr. Clarence B. Des Jardins was on the brief, for the Overland Motor Company.*

*Mr. Frank Parker Davis, with whom Messrs. Philip Mauro, Clarence S. Walker, and Reeve Lewis were on the brief, for the Packard Motor Company et al.*

*Mr. Donald M. Carter filed a brief as amicus curiae by special leave of Court.*

MR. CHIEF JUSTICE TAFT delivered the opinion of the Court.

This case comes from the Circuit Court of Appeals of the Seventh Circuit, upon a certificate of two questions for our consideration and answer. Section 239 of the Judicial Code, as amended by Act of February 13, 1925, c. 229, 43 Stat. 936. The suit is one in which the Packard Motor Car Company and the Wire Wheel Corporation seek to enjoin an alleged infringement by the Overland Motor Company of the Cowles Patent, No. 1,103,567, issued to Cowles on July 14, 1914, and owned by them. On August 25, 1899, Cowles filed an application which was duly granted July 13, 1900. His application disclosed the matter in suit. The Patent Office, however, required a division of claims, and he canceled all claims

as well as the description and drawing in the specification that supported such claims, bearing upon the subject matter of the present controversy. In that case the patent as granted covered merely the remaining claims. September 6, 1901, he filed another application, not a divisional application, disclosing and claiming, among other things, the subject matter in suit. This was pending in the Patent Office until January 21, 1913, when a patent issued for it. Certain claims made by him were repeatedly rejected by the Patent Office. Cowles complied with the requirements of § 4894, Rev. Stats., requiring an applicant to reply to the action of the Patent Office within a year, but on seven different occasions he delayed more than eleven months before filing his response to the Patent Office ruling. On May 20, 1911, the Patent Office finally rejected the only claim remaining in the application which was directed to the subject matter in issue, holding that it was unpatentable on certain references. On May 17, 1912, Cowles canceled this finally rejected claim from his application, stating his intention to file a divisional application covering the subject matter of this claim. No such divisional application had ever been directed or suggested by the Patent Office. A patent was then (January 21, 1913) issued on other claims without any claim to the subject matter in issue. On August 6, 1912, Cowles filed an application for a patent which he stated was a division of the application filed September 6, 1901, and which disclosed and sought the claims in issue. The patent in suit was then issued on this application on July 14, 1914. During its pendency in the Patent Office, Cowles complied with the requirements of § 4894, Rev. Stats., although on one occasion he delayed over eleven months before responding to the Patent Office action. During the period from 1905 to 1912, trade journals of the United States and Great Britain published articles disclosing the subject matter in issue, and certain

British patents were granted, on subjects relating to such subject matter. The publications and patents represented independent work in Great Britain, and, as a result thereof, there was actual use of the subject matter in suit abroad during the pendency of the original and divisional applications above referred to. No product embodying the subject matter of the claims in suit appeared upon the market in the United States prior to the issuing of the patent in suit. Upon these facts, the first question certified is as follows:

"Did the applicant, in canceling the claim which was finally rejected on May 20, 1911, abandon such claim or estop himself from thereafter seeking it through a new application?"

We do not find in the statement of facts any circumstances which can be held to be an abandonment by Cowles of his claim for which he subsequently secured this patent. On May 20, 1911, the claim was rejected on account of its non-patentability in view of certain references. On May 17, 1912, he canceled the claim, stating at the time that it was his intention to file a divisional application covering this subject matter. After he had done this, on August 6th, less than four months after the cancellation, he filed the claim as a divisional application under the earlier case, and this new application, with the renewed claim, went to patent on July 14, 1914. We can not see why he was estopped by his failure to appeal from the final rejection. It is quite true that, after such rejection, the Commissioner of Patents might have refused to consider his divisional application, as he made it without suggestion or consent by the Patent Office. In a qualified and limited sense, a claim rejected as this was constitutes *res judicata* in favor of the Government and against the applicant. This is fully explained by Judge Morris in *In re Barratt's Appeal*, 14 App. D. C. 255, in speaking of a case presenting a similar question:

"While the rules that govern the finality and conclusiveness of adjudications at the common law do not apply, in the strict sense, to administrative or quasi-judicial action in the Executive Departments of Government, yet in administrative action, as well as in judicial proceeding, it is both expedient and necessary that there should be an end of controversy. Sometimes, the element of finality is inherent in the nature of the action taken; as, for example, when letters patent have been granted, they may not be recalled, and the rights of the parties holding them again investigated. Where rights have become vested as the result of legitimate executive action, such action is necessarily final, and it is not competent thereafter for executive action to divest them, either by way of a review of the proceedings or by any new proceedings instituted with that view. Especially is this principle applicable to the proceedings of the Patent Office, which are so nearly akin to judicial proceedings as to be most appropriately designated as quasi-judicial."

Following then the analogy, he finds that such a case as this may constitute *res judicata* in a sense; but he qualifies the statement in this important way:

"In what we have said we do not desire it to be understood that the Patent Office may not, if it thinks proper so to do, entertain and adjudicate a second application for a patent after the first application has been rejected. What we decide is, that it is not incumbent upon the office as a duty to entertain such applications, and that, if it refuses to entertain them, it has a perfect legal right so to do. An applicant is not legally aggrieved by such refusal."

This qualification is approved in the case of *In re Fay*, 15 App. D. C. 515; *In re Edison*, 30 App. D. C. 321, 323; and in *Gold v. Gold*, 34 App. D. C. 229.

As the Patent Office by granting the patent must be held to have waived any objection to the application

on the ground that the claim allowed had been rejected before by that Office, there is no reason why the appellees below should not be allowed to avail themselves of the waiver. We answer the first question in the negative.

Second: The second question was as follows:

"In the absence of any other excuse for lapse of time between Patent Office actions and responses thereto, than that the applicant was exercising a statutory right (R. S. Sec. 4894 as amended setting limit of one year for response), may the bill of complaint be dismissed for want of equity because of long pendency in the Patent Office?"

We think that under the decision of this Court in *United States v. American Bell Telephone Company*, 167 U. S. 224, and *Chapman v. Wintroath*, 252 U. S. 126, this question must also be answered in the negative.

By § 12 of the Act of 1861 (12 Stat. 246), it was required that all applications for patent should be completed and prepared for examination within two years after the filing of the petition, and, in default thereof, were to be regarded as abandoned by the parties thereto, unless shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable. There was no provision limiting the time of the prosecution of the application in this section. By the Act of 1870 (16 Stat. 198), it was provided, in § 32, that all applications for patent should be completed and prepared for examination within two years after the filing of the petition, and in default thereof, or upon failure of the applicant to prosecute the same within two years after any action therein, of which notice shall have been given to the applicant, they should be regarded as abandoned by the parties thereto, unless shown to the satisfaction of the Commissioner that such delay was unavoidable. This provision of the Act of 1870 was carried into the Revised Statutes as § 4894, and so the statute stood until 1897, when, by 29 Stat. 692, § 4894 was amended as follows:

"All applications for patents shall be completed and prepared for examination within one year after the filing of the application, and in default thereof, or upon failure of the applicant to prosecute the same within one year after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable."

Counsel for the alleged infringer says, that even with the time limit for action on the part of the applicant thus reduced to one year, it becomes easily possible for an applicant, after an action by the Patent Office upon his application, to delay for the full period of a year his response to such action, and however promptly the Patent Office may again act, he can delay another full year before replying to it, and thus, by waiting a year after each official action, (1) keep his application pending so as to enable him to withhold, indefinitely, his invention from the public, (2) add claims to his application covering the independent intervening developments of others, and (3) postpone the time when the public may enjoy the free use of the invention—all contrary to sound public policy.

The answer to this argument is that the matter is entirely within the control of Congress, and, in order to avoid the evil suggested, Congress may reduce the time within which one who is seeking an adjustment with the Patent Office, in order to obtain a patent, shall act upon receipt of notice of a decision of the Patent Office in the course of the application through that office. Congress, as we have seen by the history of the statute, reduced this time from an indefinite period in 1861 to two years in 1870, and to one year in 1897, and, as provided in the last Congress, to six months. Act of March 2, 1927, c. 273, 44 Stat. 1335.

During the pendency of the application in this case, the period allowed was one year. We do not know on what principle we could apply the equitable doctrine of abandonment by laches, in a case where the measure of reasonable promptness is fixed by statute, and no other ground appears by reason of which laches could be imputed to the applicant.

In *United States v. American Bell Telephone Company*, 167 U. S. 224, the Government brought a proceeding in equity to cancel a patent on the ground that it had been fraudulently secured, and part of the fraud of the patentee was that he had unreasonably delayed the obtaining of the patent, by collusion with officials of the Department, through their non-action, and thus postponed the period during which the monopoly of the patent was to continue. The court found no evidence of any collusion or fraud by the officials of the Department or undue or improper influence exerted or attempted to be exerted upon them. It said that Congress had established a department with officials selected by the Government, to whom all applications for patents must be made, had prescribed the terms and conditions of such applications and entrusted the entire management of affairs of the department to those officials, and that when an applicant for a patent complied with the terms and conditions prescribed and filed his application with the officers of the department, he must abide their action and could not be held to suffer or lose rights by reason of any delay on the part of those officials. The court said:

"Neither can a party pursuing a strictly legal remedy be adjudged in the wrong if he acts within the time allowed, and pursues the method prescribed by the statute. . . . Under section 4386, Rev. Stat., an inventor has two years from the time his invention is disclosed to the

public within which to make his application, and unless an abandonment is shown during that time he is entitled to a patent, and the patent runs as any other patent for seventeen years from its date. He cannot be deprived of this right by proof that if he had filed his application immediately after the invention the patent would have been issued two years earlier than it was, and the public therefore would have come into possession of the free use of the invention two years sooner. The statute has given this right, and no consideration of public benefit can take it from him. His right exists because Congress has declared that it should. . . . A party seeking a right under the patent statutes may avail himself of all their provisions, and the courts may not deny him the benefit of a single one. These are questions not of natural but of purely statutory right. Congress, instead of fixing seventeen had the power to fix thirty years as the life of a patent. No court can disregard any statutory provisions in respect to these matters on the ground that in its judgment they are unwise or prejudicial to the interests of the public."

The case of *Chapman v. Wintroath*, 252 U. S. 126, was an attempt in an interference suit to defeat a patent granted to the Chapmans on a divisional application, for an improvement in deep well pumps, in which the claims were the same as the claims of a patent to Wintroath, the divisional application having been made twenty months later than the date of the issue of the patent to Wintroath. It was conceded that the claims had been disclosed in the Chapman patent, which had been applied for in 1909 but which had met unusual difficulties in the Patent Office and, though regularly prosecuted as required by law and the rules of the office, was still pending without having been passed to patent in 1915, when the controversy arose. It was admitted that the inven-

tion was clearly disclosed in the parent application of the Chapmans, but it was contended that their divisional application claiming the discovery should be denied, because of their delay of nearly twenty months in filing it after the publication of Wintroath's patent, when they had by law only one year. It was held by the Court of Appeals of the District (*Wintroath v. Chapman*, 47 App. D. C. 428) that the delay of more than a year constituted equitable laches and estopped the Chapmans from making their divisional claim. That holding had rested on a previous decision by the Court of Appeals in *Rowntree v. Sloan*, 45 App. D. C. 207. This Court held that under § 4886 of the Revised Statutes, as amended March 3, 1897, two years was granted in such a case before the right to file a divisional application had been lost. The Court based its decision that the statutory period could not be reduced by equitable considerations or those of public policy on the language which we have just quoted from Mr. Justice Brewer in his opinion in the *Telephone case*. The same doctrine is to be found in *Crown Cork & Seal Company v. Aluminum Company*, 108 Fed. 845, and *Columbia Motor Car Company v. Duerr & Company*, 184 Fed. 893.

The case of *Woodbridge v. United States*, 263 U. S. 50, is cited by counsel for the defendant to sustain their view that this is a case in which the doctrine of laches and abandonment may be enforced. The *Woodbridge* case was an exceptional one. Woodbridge had deliberately delayed the issue of the patent, which he could have had for the asking, for nine years. He had directed the Patent Office to keep the papers upon which such issue might have been granted in the secret archives of the Patent Office, there to remain for one year, a privilege which was given him under the law as it then existed. He failed after the one year to apply for the patent because, as he avowed in a subsequent application, he wished there-

by to postpone the period of its monopoly until a national emergency might arise in which his invention, which was for rifling cannon, should be more in demand than it then was. He was denied a patent, for failure to comply with the statute. Subsequently he secured special legislation imposing the condition that he should be granted the patent, provided the court should first be satisfied that he had not forfeited or abandoned his right to a patent by publication, delay, laches or otherwise. This Court held that the delay of nine years for the avowed purpose of postponing the period of the monopoly was laches and a breach of the condition upon which he might avail himself of the special congressional privilege granted him. Such a case has certainly no application here. The answer to the question should be in the negative.

*Questions answered "No."*

### MESSEL v. FOUNDATION COMPANY.

CERTIORARI TO THE SUPREME COURT OF THE STATE OF LOUISIANA.

No. 202. Argued March 9, 1927.—Decided May 31, 1927.

1. Art. 2315, Rev. Code of Louisiana, providing: "Every act whatever of man that causes damage to another obliges him by whose fault it happened to repair it," applies to personal injuries suffered by a workman while engaged in repairing a vessel afloat on waters of the United States and due to the negligence of his employer. P. 432.
2. Such cause of action, under Art. 2315, is not barred by the Louisiana Workmen's Compensation Act which provides special means and measures for adjusting claims for personal injuries in certain occupations, including repair of vessels, and declares its remedies exclusive, but does not by its terms include maritime injuries or torts under federal law. P. 432.
3. Art. 2315, Louisiana Rev. Code, *supra*, furnishes the equivalent of a "common law remedy," saved to suitors in the state court by § 9, Judiciary Act of 1789, § 256 Jud. Code. P. 433.



Customs and Patent Appeals.

Frederick Rushmore, Richard  
and Charles  
Petitioners,

Commissioner of Patents and  
Respondent.

No. 79-538.

1979.

of writs of mandamus and  
of Patents and Trademarks,  
Application serial No. 690,732. The  
Appeals, Miller, J., held that:  
under All Writs Act in aid of  
jurisdiction, where ruling of  
Deputy Assistant Commissioner of Patents  
and Trademarks prevented appeal of examiner's action to Board of Appeals  
from whose decision an appeal might be taken to the court  
and record showed what had been invented by petitioners,  
what was invented by other applicants and who was prior  
inventor of respective inventions. Patent Office Practice  
Rules, rule 78(c), 35 U.S.C.A. App.; 35 U.S.C.A. §§ 102(g),  
103, 141.

Notes

Independent grant of appellate  
jurisdiction which the writs are  
based on. 28 U.S.C.A. §

and Patent Appeals does not  
to review decisions of  
Trademarks in patent matters.  
decisions or matters which  
interference, but Court has  
All Writs Act in aid of its  
action by Commissioner, or  
y, that would frustrate such  
n. 28 U.S.C.A. § 1651(a).

### [3] Patents ⇨113(1)

291k113(1) Most Cited Cases

Court of Customs and Patent Appeals had power to issue  
writs under All Writs Act in aid of its prospective appellate  
jurisdiction, where ruling of abandonment by Deputy  
Assistant Commissioner of Patents and Trademarks  
prevented appeal of examiner's action to Board of Appeals  
from whose decision an appeal might be taken to the court  
and record showed what had been invented by petitioners,  
what was invented by other applicants and who was prior  
inventor of respective inventions. Patent Office Practice  
Rules, rule 78(c), 35 U.S.C.A. App.; 35 U.S.C.A. §§ 102(g),  
103, 141.

### [4] Patents ⇨101(1)

291k101(1) Most Cited Cases

Manual of Patent Examining procedure was invalid to  
extent that it authorized examiner, under threat of  
abandonment, to require petitioners who applied for patent  
and whose application incorporated by reference, another  
application both of which had been assigned to one  
corporation, to limit claims of the incorporated application,  
since regulation providing for elimination of conflicting  
claims from all but one application of same applicant did  
not provide such authority when applications were from  
different inventors and owned by common assignee. Patent  
Office Practice Rules, rule 78(b, c), 35 U.S.C.A. App.

### [5] Federal Courts ⇨524

170Bk524 Most Cited Cases

Authority under All Writs Act is not confined to issuance of  
writs in aid of jurisdiction already acquired by appeal, but  
extends to those cases which are within court's appellate  
jurisdiction although no appeal has been perfected. 28  
U.S.C.A. § 1651(a).

### [6] Patents ⇨113(1)

291k113(1) Most Cited Cases

Where mandamus was only adequate means available to  
permit petitioners to obtain review by Board of Appeals of  
ruling of Deputy Assistant Commissioner for Patents that  
petitioner's application had become abandoned and to secure  
eventual appellate jurisdiction of Court of Customs and  
Patent Appeals, court would exercise its power to issue writ  
of mandamus and petitioners would not be required to  
revive their application, a useless act. 35 U.S.C.A. §§ 102,  
102(g), 103; Patent Office Practice Rules, rules 137, 201(c),  
35 U.S.C.A. App.; 28 U.S.C.A. § 1651(a).

\*436 William H. Vogt III, New York City (Watson,  
Leavenworth, Kelton & Taggart, New York City), attys. of  
record, for petitioners; Morris N. Reinisch, New York City,  
of counsel.

ferred contact temperature  
ied, and excessively high  
a Solid vegetable material  
200 C are claimed. In their  
scribe their invention as "a  
an improvement over the  
aro et al." [FN3]

No. 690,732, filed May 27.

has been on appeal to the  
and Trademark Office  
peals since July 10, 1978.  
itioners and Pagliaro et al.  
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A., a Swiss corporation.

file wrapper indicates that  
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examiner rejected petitioner's  
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17. Petitioners responded by  
pending application is Not  
under 35 U.S.C. s 102(g).  
substantially repeated the  
ion, this time relying on the  
lication serial No. 742,094,  
'17 having been abandoned.  
fferent inventive entities of  
and the instant application  
concept including variations  
which would be obvious in  
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on before us:

in 690,732 decaffeinating a  
of vegetable material with a  
material where the phases of  
extract are maintained in  
whereas in application Serial  
recites contacting a caffeine  
a liquid water immiscible  
re between 500 C and 1200  
ed as an aqueous extract of  
ordingly in accordance with  
e in the Examiner's opinion  
in the case, the assignee is



called on to state which entity is the prior inventor of the subject matter and to limit the claims of the other application accordingly. (Emphasis added.)

FN4. The Manual of Patent Examining Procedure ("MPEP") 804.03, which is based on 37 CFR 1.78(c) (note 8, *Infra*), provides, in pertinent part: 804.03 Terminal Disclaimer Not Applicable Commonly Owned Cases of Different Inventive Entities (R-53)

In view of 35 U.S.C. 135, it is necessary to determine priority of invention whenever two different inventive entities are claiming a single inventive concept, including variations of the same concept each of which would be obvious in view of the other. This is true regardless of ownership and the provision of 37 CFR 1.201(c) that interferences will not be declared or continued between commonly owned cases unless good cause is shown therefor. A terminal disclaimer can have no effect in this situation, since the basis for refusing more than one patent is 35 U.S.C. 102 or 103, and is not connected with any extension of monopoly.

Accordingly, the assignee of two or more cases of different inventive entities, containing conflicting claims must maintain a line of demarcation between them. If such a line is not maintained, the assignee should be called on to state which entity is the prior inventor of that subject matter and to limit the claims of the other application accordingly. If the assignee does not comply with this requirement, the case in which the requirement to name the prior inventor was made will be held abandoned.

The response to the examiner's request was due on June 2, 1978, and petitioners responded on that date. They argued, as they had previously, that the disclosure of a pending application is not available as citable prior art under 35 U.S.C. s 102(g); further that there were no conflicting claims since their application claimed the use of an aqueous extract of vegetable material with a contact temperature of at least about 65o C; whereas, contrary to the examiner's interpretation, serial No. 742,094 disclosed that when aqueous extracts are used, contact temperatures should not exceed 50o C. They also pointed out that, contrary to the examiner's interpretation, only when the vegetable material is solid is the contact temperature to be between 50o C and 120o C. With respect to the examiner's request, petitioners stated:

The Examiner's assertion of applicability of MPEP 804.03 is misplaced, and is traversed. A reading of the claims in the respective applications shows that there are no conflicting claims, and that the two applications are indeed directed to distinct and different inventions,

claimed by different inventive entities. The claims of the two applications have been and are limited to the respective inventive contributions. The applicants in Serial No. 742,094 are the inventors of the subject matter claimed therein; and the applicants in the present application are the inventors of the subject matter claimed herein.

Subsequently, on June 30, 1978, petitioners filed a Notice of Appeal on the 35 U.S.C. s 103 rejection, based on 35 U.S.C. s 102(g), to the Board of Appeals.

In a third office action dated August 8, 1978, which was made final, the examiner withdrew the rejection under 35 U.S.C. s 103, apparently agreeing with petitioners' arguments that under the prevailing case law a pending application is not citable as prior art for purposes of 35 U.S.C. s 102(g). [FN5] However, he maintained his position that petitioners' claims and those in serial No. 742,094 were directed to "a single inventive concept including variations thereof each (of) which would be obvious in view of the others." Repeating his prior request, the examiner stated:

FN5. Although the examiner also made a 35 U.S.C. s 112 rejection, as a result of a personal interview with counsel for petitioners, this rejection was withdrawn.

(A)pplicants are once again called on to state Which entity is the prior inventor of the subject matter and to limit the claims \*439 of the other application accordingly. If the assignee does not comply with this requirement, this case will be held to be abandoned as per MPEP 804.03. (Emphasis added.)

In addition, the examiner said that the Claims of Pagliaro et al.'s application (serial No. 742,094) should be amended to expressly exclude petitioners' claimed temperature range when an aqueous extract is used. Thus, at this stage of prosecution, no rejections, labelled as such, remained. Accordingly, on or about August 15, 1978, petitioners withdrew their appeal to the Board of Appeals.

Having failed to persuade the examiner that he was in error, petitioners then petitioned the Commissioner pursuant to CFR 1.181(a) [FN6] and 1.183. [FN7] The decision with respect to that part of the petition relating to 37 CFR 1.181(a) was delegated to the Director of Patent Examining Group 170. The Group Director denied that part of the petition in a ruling dated November 15, 1978:

FN6. S 1.181 Petition to the Commissioner.

FN(a) Petition may be taken to the Commissioner (1) from any action or requirement of any examiner in the ex parte prosecution of an application which

is not subject to appeal to the Board of Appeals or to the court; (2) in cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and (3) to invoke the supervisory authority of the Commissioner in appropriate circumstances.

**FN7. S 1.183 Suspension of rules.**

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner in person on petition of the interested party, subject to such other requirements as may be imposed.

It is apparent from a review of the examiner's action that he has carefully considered applicants' arguments in this matter. There is no clear error in the examiner's conclusion that a line of demarcation has not been maintained between the claims of the commonly assigned applications. Moreover, assuming arguendo that the assignee is of the correct opinion that no conflict exists, there is no provision that enables the assignee to delay naming the prior inventor. Thus it is not seen that the examiner has abused his authority in making the requirement and the petition is Denied.

The consequences of failing to comply with this requirement are clearly identified in M.P.E.P. 804.03 and this application will be held to be abandoned if proper response to the requirement is not made. The period for response is extended to expire FOUR MONTHS from August 8, 1978, the date of the final rejection.

It is noted that the avenue of appeal becomes open in the event applicant should disagree with any rejection based on the election. (Emphasis in original.)

The portion of the petition relating to 37 CFR 1.183, which was a request to waive 37 CFR 1.78(c), [FN8] was denied on December 20, 1978, by the Deputy Assistant Commissioner for Patents, who stated:

**FN8. 37 CFR 1.78(c) reads:**

Where two or more applications, or an application and a patent naming different inventors and owned by the same party contain conflicting claims, the assignee may be called upon to state which named inventor is the prior inventor. In addition to making said statement, the assignee may also explain why an interference should be declared or that no conflict exists in fact.

The provisions of 37 CFR 1.183 permit the Commissioner to waive or suspend any requirement of the regulations which is not a requirement of the statutes in an extra-ordinary situation when justice requires. Since the assignee has the unique knowledge of invention dates

pertaining to conflicting claims in commonly assigned applications, the consequences associated with withholding this information, which is relevant to a determination of patentability in those applications, are calculated to induce compliance with the requirement. As such, this is not deemed an extraordinary situation wherein justice requires waiver or suspension of the rules.

**\*440** The Deputy Assistant Commissioner did not stop there. Notwithstanding the fact that the examiner had issued a third and final office action and that the Group Director, who decided the portion of the petition relating to 37 CFR 1.181(a), had extended the period to respond to that office action, the Deputy Assistant Commissioner ruled that petitioners' application became abandoned as of June 3, 1978. He reasoned that since petitioners' response to the second office action [FN9] failed to specify who was the prior inventor, as requested by the examiner, and since that failure was not inadvertent, the application became abandoned for failure to prosecute by virtue of 35 U.S.C. s 133 [FN10] and 37 CFR 1.135.[FN11] The petition before us followed.

**FN9.** As discussed Supra, the response to this office action was due on June 2, 1978, and petitioners responded on that date.

**FN10. S 133. Time for prosecuting application**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

**FN11. S 1.135 Abandonment for failure to respond within time limit.**

(a) If an applicant fails to prosecute his application within six months after the date when the last official notice of any action by the Office was mailed to him, or within such shorter time as may be fixed (s 1.136), the application will become abandoned.

(b) Prosecution of an application to save it from abandonment must include such complete and proper action as the condition of the case may require. The admission of an amendment not responsive to the last official action, or refusal to admit the same, and any proceedings relative thereto, shall not operate to save the application from abandonment.

(c) When action by the applicant is a bona fide

attempt to advance the case to final action, and is substantially a complete response to the examiner's action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, opportunity to explain and supply the omission may be given before the question of abandonment is considered.

(d) Prompt ratification or filing of a correctly signed copy may be accepted in case of an unsigned or improperly signed paper. (See s 1.7.)

#### OPINION

[1][2][3] The threshold question is whether this court has the Power to issue the requested writs, as distinguished from the question of whether the court, in its discretion, should exercise that power. Cf. *La Buy v. Howes Leather Co.*, 352 U.S. 249, 77 S.Ct. 309; 1 L.Ed.2d 290 (1957); *Roche v. Evaporated Milk Ass'n*, 319 U.S. 21, 63 S.Ct. 938, 87 L.Ed. 1185 (1943); *Reddy v. Dann*, 529 F.2d 1347, 188 U.S.P.Q. 644 (CCPA 1976). The solicitor's position is that this court lacks such power since it has no jurisdiction, by appeal or otherwise, to review a decision by the Commissioner holding an application abandoned. However, under 28 U.S.C. s 1651(a), [FN12] the All Writs Act, this court has the power to issue all writs necessary or appropriate "in aid of" its appellate jurisdiction. *Loshbough v. Allen*, 404 F.2d 1400, 56 CCPA 913, 160 U.S.P.Q. 204 (1969). Since the All Writs Act is not an independent grant of appellate jurisdiction, the appellate jurisdiction for which the writs are "in aid of" must have some other basis. See *Roche v. Evaporated Milk Ass'n*, supra, 319 U.S. at 23-26, 63 S.Ct. 938; *Goodbar v. Banner*, No. 79-555, 599 F.2d 431 (Cust. & Pat.App.1979); *Formica Corp. v. Lefkowitz*, 590 F.2d 915, 200 U.S.P.Q. 641 (CCPA 1979). While it is generally true that this court does not have appellate jurisdiction to review decisions of the Commissioner in patent matters, *In re Wiechert*, 370 F.2d 927, 54 CCPA 957, 152 U.S.P.Q. 247 (1967), except indirectly with respect to decisions on matters which are ancillary to priority in an interference, See *Godtfredsen v. Banner*, No. 79-514, 598 F.2d 589 (Cust. & Pat.App.1979), and *Duffy v. Tegtmeyer*, 489 F.2d 745, 180 U.S.P.Q. 317 (CCPA 1974), the court clearly has the power to issue writs \*441 under the All Writs Act in aid of its prospective appellate jurisdiction in the face of action by the Commissioner or those acting under his authority that would frustrate such prospective appellate jurisdiction. See *Roche v. Evaporated Milk Ass'n*, supra, 319 U.S. at 25-26, 63 S.Ct. 938; *McClellan v. Carland*, 217 U.S. 268, 280, 30 S.Ct. 501, 54 L.Ed. 762 (1910); *National Farmers' Organization, Inc. v. Oliver*, 530 F.2d 815, 816-17 (8th Cir. 1976); *Environmental Defense Fund, Inc. v. Ruckelshaus*, 142 U.S.App.D.C. 74, 82-3, 439 F.2d 584, 592-93 (1971). As developed hereinafter, the ruling of abandonment by the Deputy Assistant Commissioner was such an action in that

it prevented an appeal of the examiner's action to the Board of Appeals from whose decision an appeal might be taken to this court.[FN13]

#### FN12. S 1651 Writs

(a) The Supreme Court and all courts established by Act of Congress may issue all writs necessary or appropriate in aid of their respective jurisdictions and agreeable to the usages and principles of law.

FN13. This does not mean that every ruling of abandonment will support the issuance of a writ of mandamus or prohibition. Only under extraordinary circumstances or when there is a clear abuse of discretion will this court issue such a writ.

As related above, the examiner requested, under threat of abandonment of the application, that petitioners state which inventive entity, petitioners or Pagliaro et al., "is the prior inventor of the subject matter (of allegedly conflicting claims)," [FN14] and that petitioners' assignee limit the claims of the other application accordingly.[FN15] 37 CFR 1.78(c) sets forth the requirement that petitioners state "which named inventor (as between Pagliaro et al. and petitioners) is the prior inventor.[FN16] The regulation does not provide that, upon threat of abandonment of their application, petitioners may be required to state which inventive entity is the prior inventor of the subject matter of conflicting claims, MPEP 804.03 to the contrary notwithstanding. If petitioners did not believe there were conflicting claims, their only available response was to state who is the prior inventor of their respective inventions. Indeed, 37 CFR 1.78(c) clearly provides that petitioners have the right to explain "that no conflict exists in fact." They exercised this right by traversing the examiner's assertion of the applicability of MPEP 804.03.

FN14. Although the regulations do not define "conflicting claims," MPEP 804.03 uses this term to describe "a single inventive concept (claimed by different inventive entities), including variations of the same concept each of which would be obvious in view of the other." Since the examiner's request was based upon MPEP 804.03, we will accept this as a definition of "conflicting claims" for purposes of this appeal. However, it is unnecessary for us to decide whether, in fact, there are conflicting claims.

Although the examiner stated in his second office action that "there are conflicting claims in the (petitioners') case" and in his third office action that petitioners' claims and the claims of Pagliaro et al. are directed to "a single inventive concept including (obvious) variations thereof," he did not

specify the "subject matter" (nor did he specify which of petitioners' claims conflicted with the claims of the Pagliaro et al. application) for which petitioners were to name the prior inventor. It is incumbent upon an examiner in making a request pursuant to 37 CFR 1.78(c) to specify the "subject matter" so that an applicant Can name the prior inventor thereof.

FN15. In the third office action, the examiner suggested specific changes in the claims of the Pagliaro et al. application that he regarded as essential.

FN16. 37 CFR 1.78(c) was promulgated for the purpose of providing a "basis for requiring a determination of priority without an interference by the common owner of a plurality of applications, or patent and applications, containing conflicting claims." 36 Fed.Reg. 7312 (1971).

Petitioners responded to the requirement of 37 CFR 1.78(c) by stating that "the applicants in Serial No. 742,094 are the inventors of the subject matter claimed therein; and the applicants in the present application are the inventors of the subject matter claimed herein." In the context of petitioners' claims to an "improvement" over the basic Pagliaro et al. invention, their response to the examiner clearly was that their invention was Later than the invention of "(t)he applicants in Serial No. 742,094," and the requirement of 37 CFR 1.78(c) was satisfied. The examiner's 35 U.S.C. s 103 rejection (based on 35 U.S.C. s 102(g)) [FN17] in his \*442 first office action demonstrates his understanding that petitioners' invention was later, as does his repetition of the rejection in his second office action. Also, in his first office action, the examiner referred to certain statements in petitioners' specification as evidence of a concession that the Pagliaro et al. "application 605,717 . . . (is considered) to be prior art."

FN17. We express no opinion regarding the propriety of a 35 U.S.C. s 103 rejection based upon a pending application as prior art under 35 U.S.C. s 102(g), the issue not being before us.

Essentially, the subject matter of petitioners' allegedly conflicting claims is a process for decaffeination of coffee in an aqueous solution at a temperature of at least 65o C. Pagliaro et al., in their application No. 742,094, now pending before the Board of Appeals, claims such a process (a) broadly, with no temperature specified, as such, and (b) preferably, with the temperature not in excess of 50o C. The Solicitor suggests that petitioners, in their response to the examiner's request, should have assumed that their claims were in "conflict" with the claims of Pagliaro et al. and then, on this assumption, should have named the first inventor of

those conflicting claims. Such a suggestion indicates that the Solicitor fails to appreciate that petitioners Did name the first inventor. Petitioners stated that they were the first to invent the subject matter of Their claims (deemed "conflicting" by the examiner). However, they could not truthfully state that Pagliaro et al. were the "prior inventor" of the Whole subject matter of petitioners' allegedly conflicting claims.[FN18] Moreover, under 37 CFR 1.78(c), petitioners had the right, which they properly exercised, to traverse the examiner's assertion of the applicability of MPEP 804.03.

FN18. Such a statement would have been contrary to their oath. Moreover, to require a response wherein petitioners, in one breath, would make a statement that is clearly untrue on the record before us, and, in the next breath, would deny that statement, would be absurd.

Because the record in this case shows (a) what was invented by one applicant (petitioners), (b) what was invented by the other applicant (Pagliaro et al.), and (c) who was the prior inventor of the respective inventions, the requirement for information under 37 CFR 1.78(c) was satisfied. Thereafter, the examiner had all of the information needed to assert a 35 U.S.C. s 103 rejection, based upon 35 U.S.C. s 102(g), if he concluded that the subject matter of petitioners' claims would have been an obvious variation of the subject matter of the claims of the Pagliaro et al. application.[FN19] The correctness of such a rejection, as noted by the Group Director in his decision upholding the examiner's request, would be reviewable on appeal to the Board of Appeals.[FN20] If the board upheld the examiner's decision, this would be reviewable by this court under 35 U.S.C. s 141.

FN19. For the examiner to have required a binding admission that there are conflicting claims and (under the above-cited definition of "conflicting claims" by MPEP 804.03) that petitioners' claims are obvious variations over the claims of Pagliaro et al. would have been beyond his authority under 37 CFR 1.78(c).



FN20. It is particularly noteworthy that such a rejection (the very rejection which the Group Director indicated would be appealable) had been made, but then withdrawn after petitioners responded to the examiner's request (in the second office action) and filed an appeal of that rejection with the Board of Appeals. Withdrawal of the rejection, of course, frustrated the appeal.

Under these circumstances, the examiner's citation of MPEP 804.03 as authority to authorize abandonment of petitioners' application was misplaced.

[4] Moreover, we are persuaded that the examiner improperly required, under threat of abandonment per MPEP 804.03, that petitioners' assignee limit the claims of the Pagliaro et al. application. See *In re Mott*, 539 F.2d 1291, 190 U.S.P.Q. 536 (CCPA 1976). Although 37 CFR 1.78(b) provides for "elimination" of conflicting claims from all but one application of the same applicant, 37 CFR 1.78(c) provides no such authority when the applications are from different inventors and are owned by a common assignee, [FN21] and to the extent that \*443 MPEP 804.03 undertakes to authorize such action, it is invalid.

FN21. Thus, when the claims of a subsequent application conflict with those of an earlier application of the same inventor, such conflicting claims (which would have been obvious variations over the claims of the earlier application) may be inserted into the earlier application; however, that option is not available when the two applications have different inventors.

[5] Accordingly, we conclude that the examiner's demands, under threat of abandonment, that petitioners do more than they did amounted to a De facto rejection of petitioners' claims. [FN22] See *In re Haas*, 486 F.2d 1053, 179 U.S.P.Q. 623 (CCPA 1973); Cf. *In re Priest*, 582 F.2d 33, 199 U.S.P.Q. 11 (CCPA 1978). The subsequent ruling of abandonment by the Deputy Assistant Commissioner, precluding petitioners from an appeal to the Board of Appeals from the De facto rejection, clearly had the effect of frustrating this court's prospective appellate jurisdiction over an appeal from a decision of the Board of Appeals. As the Supreme Court stated in *Roche v. Evaporated Milk Ass'n*, supra, 319 U.S. at 25, 63 S.Ct. at 941:

FN22. In his summary of an interview with petitioners' lawyer subsequent to the third and final office action, the examiner wrote: "Exr (Examiner) was of the opinion that cls (claims) of this case  Appln Ser N 742094 were not distinguishable  there was no clear line of demarcation." Thus, the only apparent basis for such a rejection is that petitioners' claims would have been obvious over those of the Pagliaro et al. application. The question of prior inventorship was, ostensibly, fully resolved to the satisfaction of the examiner.

(A) authority is not confined to the issuance of writs in aid of a jurisdiction already acquired by appeal but extends to those cases which are within its appellate jurisdiction although no appeal has been perfected. Otherwise the appellate jurisdiction could be defeated and the purpose of the statute authorizing the writ thwarted by unauthorized action of the district court obstructing the appeal. (Citations omitted.)

*Accord. National Farmers' Organization, Inc. v. Oliver*, supra At 816; *International Business Machines Corp. v. Edelstein*, 526 F.2d 37, 40-41 (2d Cir. 1975).

[6] The remaining question is whether this court should exercise its power to issue the writs petitioners seek, recognizing that they are to be issued only in extraordinary circumstances when no meaningful alternatives are available. *Kerr v. United States District Court*, 426 U.S. 394, 403, 96 S.Ct. 2119, 48 L.Ed.2d 725 (1976). As to the requested writ of mandamus to rescind and set aside the December 20, 1978, ruling of the Deputy Assistant Commissioner for Patents that petitioners' application became abandoned as of June 3, 1978, we are persuaded that no other adequate means is available that would permit petitioners to obtain review by the Board of Appeals and to secure this court's eventual appellate jurisdiction. We agree with petitioners that the Solicitor's suggestion that they should first petition the Commissioner to revive their application is tantamount to having petitioners do a useless act. [FN23]

FN23. 37 CFR 1.137 provides for revival of an abandoned application as follows:

An application abandoned for failure to prosecute may be revived as a pending application if it is shown to the satisfaction of the Commissioner that the Delay was unavoidable. A petition to revive an abandoned application must be accompanied by a verified showing of the causes of the delay, by the proposed response unless it has been previously filed, and by the petition fee. (Emphasis added.)

As related above, the Deputy Assistant Commissioner determined that petitioners' failure to specify who was the prior inventor was not inadvertent, so it could not be shown that the "delay was unavoidable" for purposes of 37 CFR 1.137.

The Solicitor also suggests that petitioners pursue their rights in an appropriate district court so that eventual appeal to the Board of Appeals and then to this court would be available. Although this could be done, such an alternative is not consonant with the purposes of the All Writs Act, because it would place in another court the discretionary power to preserve the prospective appellate jurisdiction of this court sought by petitioners. See *Roche v. Evaporated Milk Ass'n*, supra; *Maryland v. Soper*, 270 U.S. 9, 30, 46 S.Ct. 185, 70 L.Ed. 449 (1926); \*444 *World-Wide Volkswagen Corp. v. United States International Trade Commission*, 414 F.Supp. 713, 716, 191 U.S.P.Q. 626, 628 (D.D.C.1976). Moreover, the alternative would also entail an unnecessary expenditure of scarce judicial resources.

Accordingly, we are satisfied that a writ of mandamus to

vacate the ruling of abandonment should be issued, and the writ is, hereby, issued.

As to the requested writ of prohibition restraining the Commissioner from giving effect to the course of action established by the November 15, 1978, decision of the Director of Patent Examining Group 170, such a writ appears unnecessary in view of our decision that a "proper response" to the examiner's requirement for information under 37 CFR 1.78(c) has been made, thus rendering moot any proposed action for failure to properly respond.

WRIT OF MANDAMUS GRANTED.

599 F.2d 435, 202 U.S.P.Q. 365

END OF DOCUMENT